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In The

Supreme Court of the United States

October Term, 1972

No. A-1153

EUGENE A. WAHL and VIBRA SCREW, INC.,

Petitioners,

73-207

vs.

VIBRANETICS, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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INDEX

	Page
Petition	1
Opinions Below	2
Jurisdiction	
Questions Presented	2
The Constitutional Provisions Here Involved	3
Statutes Here Involved	4
Statement of the Case	5
Fig. A	10A
Reasons for Granting the Writ	11
I. The lower courts erred in denying petitioners the opportunity to present evidence against the plea of collateral estoppel.	14
II. The lower courts erred in granting respondent's plea of collateral estoppel.	21
Conclusion	25

Index

Page

Table of Citations

CASES CITED:

American Infra-Red Radiant Co. v. Lambert Industries, Inc., 360 F.2d 977 (8th Cir. 1966) 16

Aro Mfg. Co. v. Convertible Top Replacement Co., 365 U.S. 336 (1961) . . 22

Bernhard v. Bank of America, 19 Cal. 2d 807, 122 P.2d 892 (1942) 11

Bisley, Application of, 197 F.2d 355 (C.C. P.A. 1952) 22

Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 U.S. 313 (1971) . . . . . 2, 9, 10, 11, 12, 13 . . . . . 19, 20, 21, 24, 25

Blumcraft of Pittsburgh v. Architectural Art Mfg. Inc., 459 F.2d 482, affirming 337 F. Supp. 853 13

Blumcraft of Pittsburgh v. Kawneer Co., 341 F. Supp. 1018 (N.D. Ga. 1972) 11, 13

Bourns, Inc. v. Allen Bradley Company, 348 F. Supp. 554 (N.D. Ill., E.D. 1972) . . 11

Boutell v. Volk, 449 F.2d 673 (10 Cir. 1971) 13

Index

Page

Bros., Inc. v. W.E. Grace Mfg. Co., 351 F.2d 208 (5 Cir. 1965) 22

Charles Peckat Mfg. Co. v. Jacobs, 178 F.2d 794 (7 Cir. 1949), cert. denied, 339 U.S. 915, 84 U.S.P.Q. 488 (1950) 18

Cold Metal Process Co. v. E.W. Bliss Company, 285 F.2d 231 (6 Cir. 1960), cert. denied, 336 U.S. 911 22

Coope v. Royer, 155 U.S. 565 (1895) . . . 22

Dale Electronics, Inc. v. R.C.L. Electronics, Inc., 53 F.R.D. 531 (D.N.H. 1971) . . 13

Deep Welding Inc. v. Sciaky Bros., 163 U.S. P.Q. 144 (7 Cir. 1969) 17

Filtrol Corporation v. Kelleher, 467 F.2d 242 (9 Cir. 1972) 11

Graham v. John Deere Co., 383 U.S. 1 (1966) 9, 14, 19, 21, 23, 24

Kiwi Codes Corporation v. Acro Tool & Die Works, 250 F.2d 562, 568 (7 Cir. 1957) 17

New Wrinkle, Inc. v. John L. Armitage & Co., 277 F.2d 409, 412 (3 Cir. 1960) . . . 17

Page

Nicholson v. Carl W. Mullis Engineering and Mfg. Co., 315 F.2d 532, 536 (4 Cir. 1963) 17

Samiran, In Re, 86 F.2d 756 (C.C.P.A. 1936) . . 22

Sampson v. Ampex Corporation, ___F.2d ___(2 Cir. 1973, Docket No. 72-2168) . . 11, 12, 13

Technograph Printed Circuits, Ltd. v. Martin-Marietta Corp., 474 F.2d 798 (4 Cir. 1973) 11, 12

Triplett v. Lowell, 297 U.S. 638 (1936) . . 9

United States v. Adams, 383 U.S. 39 (1966) . . 22

University of Illinois Foundation v. Blonder-Tongue Labs., Inc., 465 F.2d 380 (7 Cir. 1972) 11

Wahl v. Carrier Mfg. Co., 358 F.2d 1 (C.A. 7, 1966) 5

Wilson, In Re, 165 U.S.P.Q. 494 (C.C. P.A. 1970) 22

STATUTES CITED:

28 U.S.C. Section 1251(1) 2

35 U.S.C.A. Section 31 18

Index

Page

35 U.S.C. Section 102 . . . . . 4, 23

35 U.S.C. Section 102(a) 4, 16

35 U.S.C. Section 102(b) 4

35 U.S.C. Section 103 . . . . . 4, 23

35 U.S.C. Section 282 20

UNITED STATES CONSTITUTION CITED:

Article 1, Section 8 . . . . . 3, 19

Amendment Five 3

RULES CITED:

Federal Rules of Civil Procedure, Rule 52(a) 15, 16, 17, 19

OTHER AUTHORITIES CITED:

18 Villanova Law Review 207 (Dec. 1972) . . 11

24 U. Fla. Law Review 583 (Spring 1972) . . 11

In The

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No: A-1153

EUGENE A. WAHL and
VIBRA SCREW, INC.

Petitioners,

vs.

VIBRANETICS, INC.,

Respondent.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit

Petitioners, Eugene A. Wahl and Vibra Screw, Inc., respectfully pray that a Writ of Certiorari issue to review the Judgment and Opinion of the United States Court of Appeals for the Sixth Circuit entered in this proceeding on March 2, 1973.

Opinions Below

The Opinion of the Court of Appeals for the Sixth Circuit is reported at 177 U.S.P.Q. 243, and is reproduced in Appendix A hereto. The Order for Summary Judgment entered by the District Court for the Western District of Kentucky is reported at 176 U.S.P.Q. 234, and is reproduced in Appendix B hereto. The Opinion of the Court of Appeals for the Seventh Circuit in the related case of Wahl, et al., v. Carrier Manufacturing Co., Inc., is reported at 452 F. 2d 96, and is reproduced in Appendix C hereto. The Findings of Fact and Conclusions of Law of the District Court for the Southern District of Indiana in that said case are not reported and are reproduced in Appendix D.

Jurisdiction

The Judgment of the Court of Appeals for the Sixth Circuit was entered on March 2, 1973. An Order Extending Time to File this Petition for Certiorari was entered on May 16, 1973, in this Court. Jurisdiction is invoked under 28 U.S.C. Section 1254(1).

Questions Presented

Petitioners' patent was held invalid in the District Court for the Southern District of Indiana; the judgment was affirmed in the Court of Appeals for the Seventh Circuit, and this Court denied certiorari, 405 U.S. 990 (1972). Petitioners had also brought suit for infringement of the patent in the District Court for the Western District of Kentucky. After this Court's decision in Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 U.S. 313 (1971), the Kentucky

court granted the defendant's motion for summary judgment, in spite of petitioners' request to conduct discovery and present evidence, in support of the allegation in opposition to collateral estoppel that they had not had a full and fair chance to litigate the validity of the patent. The District Court's judgment dismissing the action was affirmed by The Court of Appeals for the Sixth Circuit. The questions are:

(1) Whether the lower courts erred in granting the motion for summary judgment and refusing to allow petitioners to supplement the record with evidence showing why an estoppel should not be imposed, and

(2) Whether the lower courts erred in holding petitioners collaterally estopped.

The Constitutional Provisions Here Involved

Art. 1, Sec. 8. "The Congress shall have power . . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Amendment 5. "No person shall . . . be deprived of life, liberty or property, without due process of law.

Statutes Here Involved

Title 35 U.S. Code, Section 102:

Section 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . . .

Title 35 U.S. Code, Section 103:

Section 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Statement of the Case

Petitioner Eugene A. Wahl, President and owner of Vibra Screw, Inc., is the owner of the patent here in question, applied for May 9, 1962 and issued March 16, 1965, No. 3,173,583 (Item 16G, E1)[1] covering a Bin Activator, which is a device for insuring the flow of dry materials from primary or main storage bins.

Mr. Wahl is also the inventor of an earlier device called a "powder feeding apparatus," the patent for which was upheld in Wahl v. Carrier Mfg. Co., 358 F.2d 1 (C.A. 7, 1966). This is a device whereby powdery material already discharged from a storage bin is received in a small hopper. Connected to the outlet of this hopper is a dispensing tube housing a screw with equally spaced flights, the rotation of which discharges the material from the open end of the tube at a predetermined and uniform volumetric rate, a process known as "metering" or "feeding" (Item 16F, 45a-46a).

The powder-feeder "enjoyed commerical success" (358 F.2d at p. 2), but worked satisfactorily only when the primary storage bin discharged the material in sufficient flow to keep the small feeder hopper supplied (Item 16F, 47a-48a). Consequently, it was useful only in conjunction with small primary bins and free-flowing materials which did not, because of their volume or consistency, tend to compact or "arch" at the outlet of the primary bin (Item 16F, 44a-45a).

1. The item numbers by which documents are referred to herein correspond to numbers on the respective documents as assigned by the District Court for the Western District of Kentucky in its certification to the Court of Appeals for the Sixth Circuit. That District Court record is collectively designated Item 2 in the Court of Appeals record certified to this Court.

To meet this difficulty, Wahl first developed a "heavy-duty screw feeder" (Item 16G, E3; Item 16F, 50a; Fig. A., infra 10A), which has a prod (sometimes referred to as a "baffle") mounted on the dispensing tube and extending upward into the discharge mouth of the bin, and a motor on the floor and attached to the dispensing tube, which vibrates both the screw and the prod. By this means, it was hoped, the prod would agitate the material in the mouth of the primary bin sufficiently to insure its constant fall out of the bin and into the small hopper connected to the dispensing tube, or directly into the tube.

The "heavy-duty screw feeder" (which is one of the three items of prior art now cited against the patent here in question) proved useful only with small bins (Item 16F, 50a-54a, 230a, 602a-604a). In large bins with high head-weight, and with obstinate materials, the contents of the bin usually "arched" above the agitating prod, which then would vibrate to no purpose (Item 16F, 57a). If there was no arching, the prod, being in the area of maximum compaction (Item 16F, 570a) would be held immovable. It is apparent that tremendous force would be required to move it — force which, if supplied by a motor fixed to the floor, would seriously damage or even destroy the building in which the feeder was housed. Precisely the same defects are inherent in the respondent's "Vibra Portioner" or "feeding apparatus" as shown in Carrier patent no. 3,187,884 (Item 16G, E26), and the Musschoot "Tray Feeder" (Item 16G, E27; Fig. A, infra 10A), the other two items of prior art on which the Court of Appeals for the Seventh Circuit relied in invalidating the petitioners' patent, here in question, for the "Bin Activator."

Statement of the Case

The problem of ensuring the steady flow of materials out of large storage bins with converging bottoms has been one of major industrial concern for many years (Item 16F, 40a).

"Why in this day of space flights, computers and harnessed atomic energy, must a laborer sledge the sides of a storage bin to move material, poke and prod to gain flow, or, in some cases, be dangerously lowered into the bin to break up bridging, with his life on the line?" reads a piece of sales literature from respondent, promoting the sale of respondent's bin activators (Item 16B, 7)

The solution, accordingly, accomplished much more than improving the functioning of metering feeders, although it was that purpose which initially turned Mr. Wahl's thinking to the bin discharge problem (Item 16F, 51a).

The "Bin Activator" resolves the difficulty by radical surgery on the storage bin itself, which removes a significant part of the conical bin bottom (and thus the region of maximum compaction) (Item 16F, 66a-68a). Substituted in its place is the patented device which is flexibly mounted to the bin and thus vibrationally isolated from bin and building (Fig. A, infra 10A). The motor vibrator (gyrator) is not in contact with the building but is attached to the side of the activator and rides with it, imparting vigorous vibration thereto. (See Fig. 4 and Col. 3 of Bin Activator patent, Item 16G, E1.) The entire activator, including the contained material, is vibrated (Item 16F, 66a-67a). Supported and secured to the inside of the activator are cross-members which in turn support and secure one or

more baffles. The baffle, vibrating with the activator, imparts vibration upward into the contents of the bin, to discourage arching overhead, and also carries a large part of the head-load, thus relieving pressure on the final outlet (Item 16F, 68a). Vibration of the activator catapults material into the space below the baffle, and insures an uninterrupted flow out of the bin activator's discharge opening (Item 16F, 567a-568a).

It is apparent, accordingly, that there is neither functional nor physical similarity between the Bin Activator and the feeding devices cited as prior art. The Bin Activator becomes a part of the Bin itself and its only function is to insure discharge of the bin's contents. The prior art devices receive, measure and carry away material already discharged from the bin (Item 16F, 580a); the vibrating prods extending upward into the mouth of the bin are ancillary and, as experience proved, ineffective adjuncts intended to stimulate flow from the bin (Item 16F, 50a, 299a, 301a and 579a). Furthermore, it is undisputed that the Bin Activator met a long felt and pervasive need for a device which would resolve the bin discharge problem (Item 16F, 234a, 235a, 244a-246a, 250a-252a).

Nevertheless, the Court of Appeals for the Seventh Circuit affirmed the Indiana District Court's judgment holding the Bin Activator patent invalid for obviousness in the light of the prior art. As is more fully described below, the Seventh Circuit's error was due to its disregard of most of the limiting language of the patent claims, which resulted in a reading broad enough to cover both of these very disparate sorts of devices.

The error appears to have been partly semantic, involving loose use of the term "material receiving means" or "material receiving member." It is true that both the Bin Activator and the feeders in the cited prior art are "material receiving means," but this does not make them similar in form or function. So, after all, are teapots and jewel cases "material receiving means". The point, overlooked by the Seventh Circuit, is that in the Bin Activator the "material receiving means" is essentially part of the bin and is a device for insuring flow from the bin, while in the Feeders cited as prior art, the "material receiving means" is a receptacle to catch the flow from the bin, measure it and carry it away. [2]

The foregoing is the gist of petitioners' claim that the Indiana District and Seventh Circuit Courts "wholly failed to grasp the technical subject matter and issues in suit," and likewise failed properly to apply the requirements of Graham v. John Deere Co., 383 U.S. 1 (1966). Confronted with this failure, petitioners sought to relitigate the matter in the Kentucky District Court, as was then the usual course under the rule of Triplett v. Lowell, 297 U.S. 638 (1936). After the decision in the Blonder-Tongue case (decided May 3, 1971), petitioners, anticipating that respondent would interpose a plea of collateral estoppel, submitted interrogatories intended to disclose by respondent's answers the mistaken nature of the Seventh Circuit's

2. Note that the first sentence of the Sixth Circuit's opinion states the operation of the patented device as being one of "imparting vibrations to the hoppers or bins" (App. 1a). This is a complete misconception, as the Bin Activator must be vibrationally isolated from the bin. (See Fig. A, infra.)

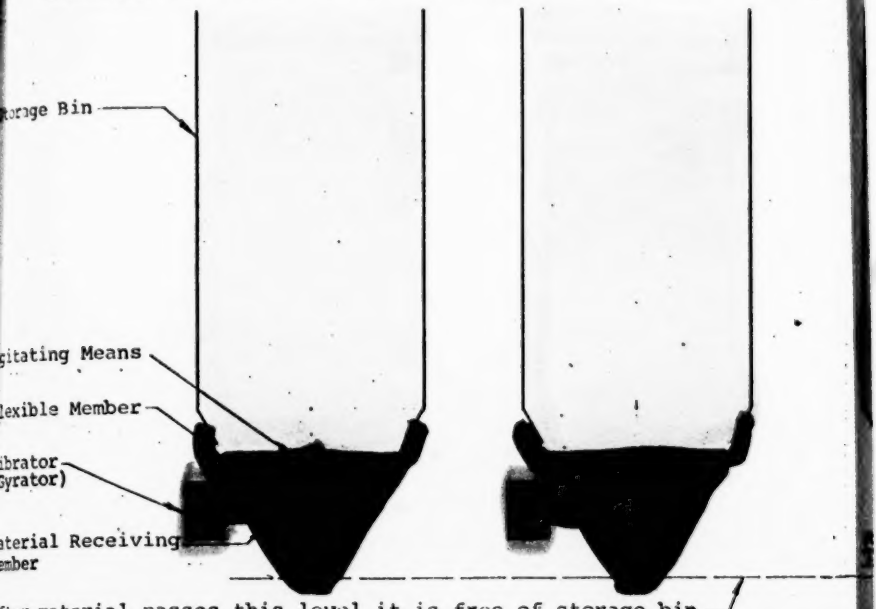
treatment of the cited prior art. See especially interrogatories 11 to 15 (Item 11, pp. 6-13). Respondent, however, moved for summary judgment, and also moved successfully and over petitioners' strong objection to hold the interrogatories in abeyance pending disposition of the summary judgment motion.

The Kentucky court, completely disregarding this Court's admonition in Blonder-Tongue (402 U.S. at 350) that a patentee plaintiff confronting a collateral estoppel plea should be allowed to offer "any evidence showing why an estoppel should not be imposed," and despite its own acknowledgment (App. 16a) that "plaintiff's numerous allegations concerning the prior suit, if proved, would successfully defeat the plea of estoppel," granted the defendant's motion for summary judgment. The Court of Appeals affirmed the District Court's judgment, primarily on the basis (App. 13a) that there is no need for the consideration of new evidence on the issue of estoppel when the record of the prior litigation is available. As is shown more fully hereinafter, the Circuit Court's conclusion rests upon a flagrant misreading and misunderstanding of this Court's opinion in the Blonder-Tongue case.

COPY BOUND CLOSE IN CENTER

PATENT IN SUIT

APPARATUS FOR PROMOTING FLOW OF MATERIAL FROM STORAGE BINS



PLAINTIFF BIN ACTIVATOR	DEFENDANT BIN ACTIVATOR
Patent filed May 1962. Licensed world-wide for Bin Discharging only.	First made November 1962. Being sold world-wide for Bin Discharging only.

ROM CLAIM 1 OF PATENT IN SUIT:

aterial Receiving Member ...

...is generally conical, having truncated apex outlet.

...has inlet opening corresponding in size to bin discharge opening.

...is supported for vigorous vibration, and is held in definite spaced relationship to bin.

...has agitating means disposed within itself, and extending substantially to inlet opening of Material Receiving Member.

...is a continuing part of bin, containing bin storage.

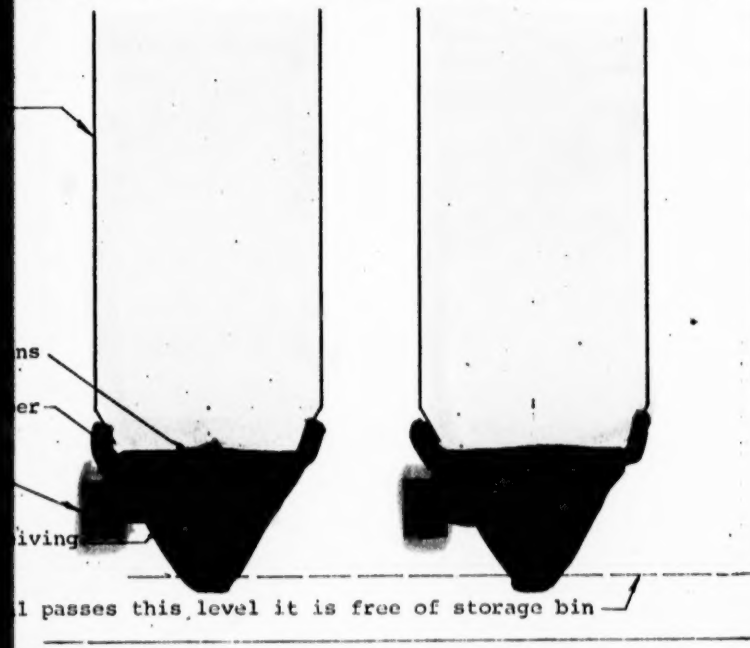
ROM CLAIM 2 OF PATENT IN SUIT:

aterial Receiving Member ...

...has eccentric weight gyrator secured to and riding with the Material Receiving Member. Gyrator forces thereby act only on Material Receiving Member, and not on surroundings. Forces as high as tens of thousands of pounds may be used, depending on size of Material Receiving Member.

PATENT IN SUIT

TUS FOR PROMOTING FLOW OF MATERIAL FROM STORAGE BINS



PLAINTIFF BIN ACTIVATOR
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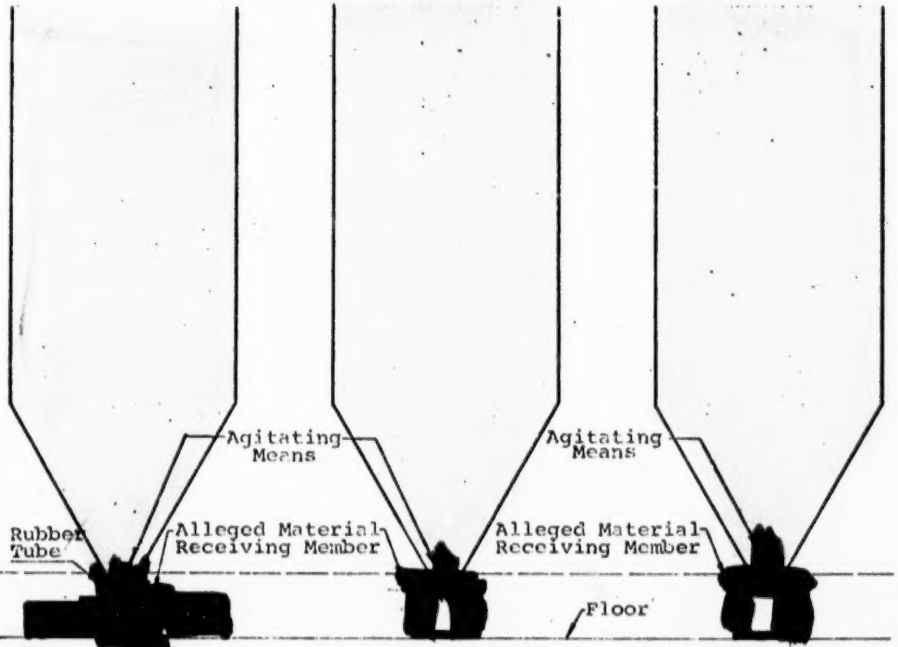
rial Receiving Member.

PRIOR ART

FEEDERS FOR METERING MATERIAL AFTER IT LEAVES THE STORAGE BIN



WAHL HEAVY-DUTY SCREW FEEDER
Used only as a Feeder from 1969 on.

DEFENDANT TRAY FEEDER VIBRA PORTIONER
Pat. filed January 1962.
Sold only as a Feeder.

MUSSCHOOT TRAY FEEDER
Patent filed 1959.
None sold.

Alleged Material Receiving Member ...

1. ...is not generally conical and has no truncated apex outlet.
2. ...has no inlet corresponding in size to bin discharge opening. Wahl Feeder uses merely a rubber tube to connect with small hopper supplied with this feeder.
3. ...is not supported for vigorous vibration, and is not held in definite spaced relationship to bin.
4. ...has no agitating means disposed within itself. Agitating means is outside Alleged Material Receiving Member.
5. ...is not a continuing part of bin, containing bin storage

Alleged Material Receiving Member ...

6. ...has no eccentric weight gyrator secured to and riding with Alleged Material Receiving Member. Vibrator forces act equally on surroundings, and are therefore limited to order of 100 lbs. If ten thousand pound forces were applied to these devices, the surrounding structure and buildings would collapse. These devices are clearly not intended for vigorous vibration as described in plaintiff patent.

Fig. A

Reasons for Granting the Writ

This Court's decision in the Blonder-Tongue case inaugurated a new era in patent litigation by eliminating mutuality as an absolute bar to collateral estoppel where a plaintiff patentee, whose patent has been declared invalid by a Federal court, sues another defendant for infringement of the same patent. Conceptually, the decision was in harmony with the trend initiated in Bernhard v. Bank of America, 19 Cal. 2d 807, 122 P. 2d 892 (1942), and in extending the Bernhard doctrine to Federal patent litigation, this Court intended primarily to reduce the cost of such litigation, eliminate "the aura of the gaming table" (402 U.S. 329), and relieve overburdened Federal court dockets (402 U.S. 348-49). There is some evidence that these objectives are already being measurably achieved, and the decision has won general approval in subsequent decisions and in legal literature.3

In opening the door wider for pleas of collateral estoppel, however, this Court was careful to insure that the new rule would not be automatically or routinely applied, and that a patentee facing such a plea should be given full opportunity to show why its application to his claim would be inequitable. Mr. Justice White's opinion

3. See, e.g., University of Illinois Foundation v. Blonder-Tongue Labs., Inc., 465 F.2d 380 (7 Cir. 1972); Filtrol Corporation v. Kelleher, 467 F.2d 242 (9 Cir. 1972); Technograph Printed Circuits, Ltd. v. Martin-Marietta Corp., 474 F.2d 798 (4 Cir. 1973); Sampson v. Ampex Corporation, ___ F. 2d___ (2 Cir. 1973, Docket No. 72-2168); Blumcraft of Pittsburgh v. Kawneer Co., 341 F. Supp. 1018 (N.D. Ga. 1972); Bourns, Inc., v. Allen Bradley Company, 348 F. Supp. 554 (N.D. Ill., E.D. 1972); 24 U. Fla. Law Review 583 (Spring, 1972); 18 Villanova Law Review 207 (Dec. 1972).

for a unanimous court takes full account of the hazards incidental to according such finality to an initial judgment of invalidity, and mandates safeguards against these dangers (402 U.S. at 332 to 334 and 350). It is clear that the Court expects the lower courts to render more than lip service to these admonitions, lest the benefits sought by the liberalized collateral estoppel plea be outweighed by unintended damage, and unjust dilution of the constitutional and statutory rights of inventors.

The principal reason for granting this petition is that this case is an egregious example of disregard of the limitations that this Court attached to the Blonder-Tongue rule. It is a case of which this Court should take disapproving cognizance, in order to forestall a general trend in the lower Federal courts toward a niggardly or nonchalant treatment of those safeguards.

It is altogether natural for a Federal District judge to look hospitably on a collateral estoppel plea in a patent case. Few Federal judges find pleasure in exercising the patent jurisdiction; most of them are struggling with inflated dockets. It is easy and inviting to dispose of an infringement suit on a patent previously held invalid by quoting Blonder-Tongue and dismissing the complaint.[4] Our research has not disclosed a single case since Blonder-Tongue in which a patentee plaintiff has been

4. See cases cited in Footnote 1, esp. Technograph and Sampson,

ible to defeat the plea.[5] No doubt in many, if not most, of these cases, the plea was rightly allowed, but such a uniformity of outcome suggests the need for a reaffirmation of the Blonder-Tongue limitations in a case, such as the present one, where those requirements have gone unheeded.

---

5. Compare Boutell v. Volk, 449 F.2d 673 (10 Cir. 1971) in which the court rightly declined to give the patentee plaintiff the benefit of collateral estoppel in his suit against the second alleged infringer. Thus, one result of Blonder-Tongue has been that although a patentee who loses the first time may well be finished, a patentee who wins the first time may have to litigate again and again. Conflicting decisions are thus possible, as it would be improper for collateral estoppel to apply to prior or subsequent decisions of validity. Note Dale Electronics, Inc. v. R.C.L. Electronics, Inc., 53 F.R.D. 531 (D.N.H. 1971) in which the District Court attempted a solution by making the infringement suit into a class action. Compare Sampson v. Ampex Corporation, supra, where estoppel was allowed although the first case had been settled prior to hearing of an appeal. See also Blumcraft of Pittsburgh v. Kawneer Co., supra, where there was an initial holding of validity in the Court of Claims, a subsequent holding of invalidity in the Fourth Circuit, and where the Georgia Northern District Court--after twice refusing to grant defendant's motion for summary judgment--granted defendant's motion for summary judgment, Blumcraft of Pittsburgh v. Kawneer Co., Index No.12847 (N.D. Ga. 9/22/72), in reliance on a decision by the Tenth Circuit affirming summary judgment against Blumcraft in an infringement suit brought by Blumcraft in the Kansas District Court, Blumcraft of Pittsburgh v. Architectural Art Mfg. Inc., 459 F.2d 482, affirming 337 F. Supp. 853. The Georgia District Court decision is now pending on appeal in the Fifth Circuit.

Reasons for Granting the Writ

I.

THE LOWER COURTS ERRED IN DENYING PETITIONERS THE OPPORTUNITY TO PRESENT EVIDENCE AGAINST THE PLEA OF COLLATERAL ESTOPPEL.

Prior to respondent's moving for summary judgment, petitioners served and filed interrogatories (Item 11). In them, petitioners sought to disclose to the District Court that the first validity determination did not employ the standards announced in Graham v. John Deere Co., 383 U.S. 1 (1965), and that the prior courts wholly failed to grasp the technical subject matter and the issues in suit.

The District Court made its decision on the summary judgment motion without awaiting answers to those interrogatories. The Sixth Circuit made no reference to the abortive interrogatories, but criticized petitioners for not responding to the motion with affidavits or anything other than a reply (App. 4a). An examination of petitioners' interrogatories will indicate that respondent's answers thereto would demonstrate more clearly than any self-serving affidavit could, that the items of prior art relied upon by the court in the initial Indiana trial were so disparate in design and function from those claimed by petitioners' patent that the holdings of anticipation and obviousness were clearly wrong. Specifically, interrogatories Nos. 11, 12, 13, 14, and 15 challenged respondent to sustain, if it could, its allegations in paragraphs 13, 14, 15 and 15 (sic), of anticipation of the petitioners' patent by those very items of prior art cited by the Indiana court in its

Findings of Fact (App. 60a-67a), Nos. 9, 10, 11, 12 and 13, which embody that Court's errors. These "findings" were unscathed by the Seventh Circuit's review, because denominated "Findings of Fact". In truth, they are conclusions of law. Figure A (10A, supra) demonstrates with simple apparency the grossness of error in the findings of obviousness and anticipation.

The Kentucky court even conceded that "plaintiff's numerous allegations concerning the prior suit, if proved, would successfully defeat the plea of estoppel..." (App. 16a) yet gave them no opportunity to prove those allegations.

The Sixth Circuit approved the District Court's summary judgment, just as the Seventh Circuit had approved the Indiana Court's Findings of Fact, without reviewing the basis of the findings of obviousness and anticipation.

Thus, embedded in a decision four courts ago, and insulated from judicial review, is an egregious error of law. How did such a thing occur?

The Seventh Circuit (App. 27a) states as follows:

> "However stated, we think the ultimate issue is whether the court's findings of fact are clearly erroneous. Rule 52 (a) of the Federal Rules of Civil Procedure provides in part:
>
> 'Findings of Fact shall not be set aside unless clearly erroneous, and due regard shall be given to opportunity of the trial court to judge of the credibility of the witnesses.'"

Reasons for Granting the Writ

But surely "credibility of witnesses" has nothing to do with the correctness of a determination of obviousness, and Rule 52(a) was never intended to shield an error in the application of law from that judicial review which is basic to the rights of a litigant in any United States court. The fallacy of such treatment of factual findings has been frequently pointed out by the lower courts. In American Infra-Red Radiant Co. v. Lambert Industries, Inc., 360 F.2d 977 (8th Cir. 1966) the Court stated (p. 988):

> "In the first place the validity of the Schwank patent did not revolve solely around the issue of 'invention' versus 'mechanical skill.' Involved first was the question of 'novelty' as set out in 35 U.S.C. 102(a). A determination of this issue involved primarily a comparison of the prior McCourt patent with the later Schwank patent to ascertain if the teachings of the former were repeated in the latter. We concluded after making such a comparison that the Schwank device was in fact fully described in the McCourt patent and thus lacked the necessary 'novelty' of patentability. Such a determination was based upon an examination and interpretation of two legal documents to determine if the statutory requirements of patentability had been fulfilled. Inasmuch as these documents are equally available to this Court, we do not believe that the trial court's particular interpretation is a factual conclusion binding under Rule 52(a). The appellate court has the prerogative to interpret the exhibits for itself. Nicholson v. Carl W. Mullis Engineering

and Mfg. Co., 315 F.2d 532, 536 (4 Cir. 1963); New Wrinkle, Inc. v. John L. Armitage & Co., 277 F.2d 409, 412 (3 Cir. 1960); Kiwi Coders Corporation v. Acro Tool & Die Works, 250 F.2d 562, 568 (7 Cir. 1957).

Secondly, the part of the trial court's decision which found the element of 'invention' in the Schwank patent we believe was induced by an erroneous view of the law. Even accepting 'invention' as being a question of fact, application of erroneous standards of invention or misconceptions as to the applicable law, in themselves make factual conclusions of patentability clearly erroneous."

And in Deep Welding Inc. v. Sciaky Bros., 163 U.S.P.Q. 144 (7 Cir. 1969), the Circuit Court found:

"It is axiomatic that findings in patent cases are like those in any other case in that they are entitled to our respect and should not be set aside unless clearly erroneous under Federal Rule of Civil Procedure 52(a). [citations omitted]. The major exception to this axiom is in situations where the evidence is documentary or where it involves the actual examination of a product or a device in operation. In such situations, the Court of Appeals has the right to interpret such evidence for itself and is as equally competent as the trial court to do so. [Citations omitted.] Careful analysis of the evidence below, both documentary and testimonial and by way of exhibits showing

welds made by the process in question, convinces us that this case is determinable upon its documentary evidence. We find ourselves in the same position as did an earlier panel of this Court in Charles Peckat Mfg. Co. v. Jacobs, 178 F.2d 794 (7 Cir. 1949), cert. denied, 339 U.S. 915, 84 U.S. P.Q. 488 (1950), which held, at 802, 84 U.S.P.Q. 4, 11:

'Findings of fact are not to be upset unless they are clearly erroneous; a court of review will not interfere with them, in the absence of a very obvious showing of error. [Citation omitted.] But the ultimate question of patentability is whether the device meets the requirement of the statutes. 35 U.S.C.A. Section 31. Here we have a finding of fact of anticipation because of existing prior art patents. Each of these documents was before the trial court and is before us. Their interpretation, in view of the statute, is as open to us as to the District Court. True, there was some parol testimony in the court below, but we find that it did not in any way throw light upon the question of anticipation by the prior art. Consequently, we feel free to review the evidence bearing upon anticipation by the prior patents.'"

Yet the Seventh Circuit contented itself with locating a piece of testimony by the witness for the alleged infringer in that case which harmonized with the trial court's erroneous conclusion of obviousness in the

prior art (App. 38a-39a), although conceding that petitioners' argument that the District Court erred was "not without plausibility" (App. 40a).

It is this misapplication of Rule 52(a) that led the Seventh Circuit to lend the dignity of its affirmance to a District Court decision which did not apply the standards of obviousness enunciated in Graham v. John Deere, supra.

Such an error in a post-Blonder-Tongue adjudication insulates from review conclusions of law reached by a single District Court judge: as such, it denies to a patentee due process of law in proceedings which deprive him of the value of his patent property.

Neither the Sixth Circuit nor the Kentucky District Court, nor the Seventh Circuit used the available documents and exhibits to evaluate whether the Indiana District Court had properly compared petitioners' patent claims to the prior art.

If the wholesome doctrine of Blonder-Tongue is not to be subverted with disastrous results to the "progress of science and the useful arts" that Article 1, Section 8 of the Constitution seeks to promote, it is imperative that lower courts apply the doctrine of obviousness with greater care than before that doctrine was enunciated.

The primary reason for granting the writ in this matter is to delineate what sort of opportunities a patent holder in the second suit must be granted to demonstrate that the prior litigation did not present him

with the requisite "full and fair chance to litigate the validity of his patent" demanded by the Blonder-Tongue decision.

Here, petitioners sought to demonstrate through interrogatories that the prior proceedings were seriously defective. By affirming a judgment where this opportunity was denied petitioners the Sixth Circuit was in error.

One other error deserves correction here. The Seventh Circuit states in its opinion that the original trial in Indiana was continued from November 14, 1967 to August 19, 1968 "on plaintiff's request" (App. 21a). The Kentucky District Court states (App. 17a):

> "... at the conclusion of proof, patentee was given an additional nine months to offer additional rebuttal evidence."

The Sixth Circuit repeats that the adjournment was "to enable the plaintiffs to prepare rebuttal to the proofs offered by the defendant" (App. 2a). The observations are apparently intended to buttress the determination that petitioners had "a full and fair chance" to litigate the validity of the patent in the first instance.

The record of the original proceeding on pages 1000-09 (Item 16F, 507a-512a) shows that on November 14, 1967, the defendant, without any 30-day notice as required by 35 U.S.C. Section 282, introduced a purported new piece of prior art, and the Court itself suggested that the trial be adjourned "to a later date."

Neither the continuance itself nor the length of it was requested by these petitioners.

II.

THE LOWER COURTS ERRED IN GRANTING RESPONDENT'S PLEA OF COLLATERAL ESTOPPEL.

Even short of the permission to conduct discovery by way of interrogatories, the lower courts had sufficient evidence before them to warrant a refusal to grant summary judgment.

Recognizing in Blonder-Tongue, supra, the "complexity of patent litigation and the posited hazard that the prior proceedings were seriously defective" (p. 333), this Court has left no question that the reach of its estoppel doctrine is limited. No plea of estoppel "must automatically be accepted" (p. 333). It must withstand certain tests prior to acceptance to insure that the first adverse judgment of invalidity was the product of a "full and fair litigation."

Because the manner in which this is to be determined may not be simple, the Court has given examples as a guide (p. 333):

> "For example, if the issue is non-obviousness, appropriate inquiries would be whether the first validity determination purported to employ the standards announced in Graham v. John Deere Co., supra; [or] whether the opinion filed by the District Court and the reviewing court, if

> any, indicate that the prior case was one of those relatively rare instances where the court wholly failed to grasp the technical subject matter and issues in suit." (Matter in brackets added.)

We submit that the Findings and Conclusions of the trial court in the Seventh Circuit show precisely such a failure to apply the Graham standards as well as serious misunderstanding of the technical content of the claims.

It is fundamental that the claims of a patent are the sole measure of the patent grant,[6] that the claims define the invention,[7] and interpretation of the claims is a question of law for the court to decide.[8]

Every element of each patent claim is deemed to be material to the inventive concept.[9] Definite limitations in a claim should never be ignored or construed out of the claim.[10] All words in a claim must be considered in judging the patentability of that claim against the prior art.[11]

---

6. Aro Mfg. Co. v. Convertible Top Replacement Co., 365 U.S. 336 (1961).

7. U.S. v. Adams, 383 U.S. 39 (1966).

8. Coupe v. Royer, 155 U.S. 565 (1895), Cold Metal Process Co. v. E.W. Bliss Company, 285 F.2d 231 (6 Cir. 1960) cert. den. 336 U.S. 911.

9. Bros., Inc. v. W.R. Grace Mfg. Co., 351 F.2d 208 (5 Cir. 1965).

10. Application of Bisley, 197 F.2d 355 (C.C.P.A. 1952); In Re Samiran, 86 F.2d 756 (C.C.P.A. 1936).

11. In Re Wilson, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Graham v. John Deere, supra, at page 17 holds:

> "Under Section 103, the scope and content of the prior art are to be determined; the differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." (Emphasis added.)

If the claims must be measured against the prior art for purposes of determining non- obviousness under 35 U.S.C. Section 103, as Graham, supra, mandates, then a fortiori it must be the claims which are to be compared to the references when the question is whether there is complete anticipation of the invention under 35 U.S.C. Section 102. Here the trial court in the Seventh Circuit found petitioners' invention to be not only obvious under Section 103 but completely anticipated under Section 102 by four separate items of prior art. In so doing it misapplied, ignored and evidently misunderstood several crucial terms of petitioners' claims.

The trial court made no attempt to find, nor could it have found, that the so-called "material-receiving member" of any of the four references was generally conical, or had an inlet opening corresponding substantially to that of the bin discharge opening, or that there was a material agitating means extending substantially to the said inlet opening of the material receiving member. By ignoring these definite claim limitations, the trial court was readily able to find the remainder of the recited elements in the prior art.

Reasons for Granting the Writ

The standards of Graham require that the claims be compared with the prior art, and in reading out of the claims a significant number of their terms, the trial court failed to apply those standards. This is precisely that manner of serious defect posited by Blonder-Tongue as a basis for holding estoppel inapplicable. The only other conceivable explanation for the trial court's failure to apply many of the terms of the claims is that it did not grasp, and therefore ignored, their technical meaning. Again, if this were so it would simply be another of the examples in Blonder-Tongue where no estoppel should be.

In either case, petitioners were not given the "full and fair" hearing on validity to which they were entitled.

It remains only to observe that motions for summary judgment should be granted with great caution. It is submitted that the limiting language of Blonder-Tongue raises the standard of such caution to a point well above that utilized in the decisions below.

Conclusion

The decisions in the lower courts since this Court's opinion in Blonder-Tongue indicate a vital need for definition of the dimension of opportunity a patent-holder must have to prove to a second court that prior proceedings upon which collateral estoppel is urged were seriously defective. The opportunity presented these petitioners is wholly insufficient and works injustice and denial of due process.

Wherefore, petitioners pray that a writ of certiorari issue to review the judgment of the Court of Appeals for the Sixth Circuit.

Respectfully submitted,

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MICHAEL RODAK, JR., CLERK

In The

Supreme Court of the United States

October Term, 1972

No. A-1153

EUGENE A. WAHL and VIBRA SCREW, INC.,

Petitioners,

73-207

vs.

VIBRANETICS, INC.,

Respondent.

APPENDIX

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Appendix

Page

Appendix A — Decision of United States Court of Appeals for the Sixth Circuit, Filed March 2, 1973 . . . . . 1a

Appendix B — Memorandum and Order of United States District Court Western District of Kentucky, Filed April 24, 1972 . . 14a

Appendix C — Decision of United States Court of Appeals for the Seventh Circuit, Filed August 30, 1971 . . . . . 20a

Appendix D — Findings of Fact and Conclusions of Law — United States District Court Southern District of Indiana Dated November 5, 1969 . . . . . 56a

Appendix A

Decision of United States Court of Appeals for the Sixth Circuit, Filed March 2, 1973

No. 72-1661

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

EUGENE A. WAHL and VIBRA SCREW, INC.,

Plaintiffs-Appellants,

v.

VIBRANETICS, INC.,

Defendant-Appellee.

APPEAL from the United States District Court for the Western District of Kentucky.

Decided and Filed March 2, 1973

Before: MILLER and KENT, Circuit Judges, and O'SULLIVAN, Senior Circuit Judge.

KENT, Circuit Judge. On March 16, 1965, plaintiff Wahl [the parties will be referred to as in the court below] was granted Patent No. 7,173,583 on a "bin activator", a device which attaches to the bottoms of storage bins or hoppers and by imparting vibrations to the hoppers or bins, facilitates the flow of powdered, granular, pulverized or like material out of the bins or hoppers.

Decision

In November 1, 1965, plaintiffs commenced an action against Carrier Manufacturing Co., Inc. in the United States District Court for the Southern District of Indiana, alleging infringement of that patent. Trial of the case commenced on November 6, 1967, and continued through November 14, 1967, when it was adjourned until August 19, 1968, to enable the plaintiffs to prepare rebuttal to the proofs offered by the defendant. Such proofs were offered on August 19, 1968. On November 5, 1969, United States District Judge William E. Steckler, Chief Judge of the Southern District of Indiana, entered judgment for the defendant, after concluding that the patent in suit was invalid. The judgment of the District Court was affirmed, 452 F.2d 96 (7th Cir. 1971), and the application for certiorari was denied, 405 U.S. 990 (1972). On December 18, 1970, after judgment of invalidity had been entered in the District Court for the Southern District of Indiana, the present suit for infringement of the same patent was filed in the United States District Court for the Western District of Kentucky. The defendant filed a timely answer claiming invalidity and lack of infringement, and on December 21, 1971, amended its answer to include a claim that the plaintiffs were estopped from suing for infringement by the prior Indiana judgment of invalidity.

Subsequently, defendant filed a motion for summary judgment based upon the same claim of estoppel. The claim of estoppel relies upon the doctrine announced by the Supreme Court in Blonder-Tongue Laboratories, Inc. v. University

of Illinois Foundation, 402 U.S. 313 (1971). In support of its motion for summary judgment, based upon estoppel, the defendant attached a copy of the transcript (1,300 pages) and record of the litigation in the United States District Court for the Southern District of Indiana, and a certified copy of the 600-page appendix, filed in the United States Court of Appeals for the Seventh Circuit. Plaintiffs filed nothing in opposition to the motion for summary judgment except a reply which alleged various deficiencies and errors in the Indiana litigation, which plaintiff claimed made the application of the Blonder-Tongue doctrine inappropriate.

The District Judge examined the transcript and record of the Indiana litigation and granted the motion for summary judgment. From that action this appeal is taken.

In this Court plaintiffs claim to be entitled to a trial to determine whether there were deficiencies in the prior Indiana litigation which would remove the instant case from the application of the doctrine enunciated in Blonder-Tongue. At the outset we point out that plaintiffs' entire reliance is on the pleadings and that nothing in support of such pleadings has ever been filed. Rule 56(e), Rules of Civil Procedure, provides in part:

> "When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of his pleading, but his

response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If he does not so respond, summary judgment, if appropriate, shall be entered against him."

Plaintiffs not only did not respond by affidavit or otherwise to the defendant's motion for summary judgment in any manner contemplated by Rule 56(e), but filed only a reply which does not "set forth specific facts showing that there is a genuine issue for trial," as required by Rule 56(e). We are, therefore, only concerned with one issue: Was summary judgment appropriate under the circumstances of this case?

In Triplett v. Lowell, 297 U.S. 638 (1936), in discussing estoppel in patent litigation, the Supreme Court said at page 644:

> "We conclude that neither the rules of the common law applicable to successive litigations concerning the same subject matter, nor the disclaimer statute, precludes re-litigation of the validity of a patent claim previously held invalid in a suit against a different defendant."

In discussing the Triplett rule in Blonder-Tongue, the Supreme Court said:

> "Thus, we conclude that Triplett should be overruled to the extent it forecloses a plea of estoppel by one facing a charge of in-

fringement of a patent that has once been declared invalid." 402 U.S. at 350.

The Court, however, made it clear that mere prior adjudication of invalidity in and of itself would not necessarily require a termination of a subsequent lawsuit between different parties. In that connection the Court stated:

> "Moreover, we do not suggest, without legislative guidance, that a plea of estoppel by an infringement or royalty suit defendant must automatically be accepted once the defendant in support of his plea identifies the issue in suit as the identical question finally decided against the patentee or one of his privies in previous litigation. Rather, the patentee-plaintiff must be permitted to demonstrate, if he can, that he did not have 'a fair opportunity procedurally, substantively and evidentially to pursue his claim the first time.' Eisel v. Columbia Packing Co., 181 F. Supp. 298, 301 (Mass. 1960). This element in the estoppel decision will comprehend, we believe, the important concerns about the complexity of patent litigation and the posited hazard that the prior proceedings were seriously defective.
>
> Determining whether a patentee has had a full and fair chance to litigate the validity of his patent in an earlier case is of necessity not a simple matter. In addition to the considerations of choice of forum and incentive

to litigate mentioned above, certain other factors immediately emerge. For example, if the issue is nonobviousness, appropriate inquiries would be whether the first validity determination purported to employ the standards announced in Graham v. John Deere Co., supra; whether the opinions filed by the District Court and the reviewing court, if any, indicate that the prior case was one of those relatively rare instances where the courts wholly failed to grasp the technical subject matter and issues in suit; and whether without fault of his own the patentee was deprived of crucial evidence or witnesses in the first litigation. But as so often is the case, no one set of facts, no one collection of words or phrases, will provide an automatic formula for proper rulings on estoppel pleas. In the end, decision will necessarily rest on the trial courts' sense of justice and equity." 402 U.S. at 332-4 (footnotes omitted).

In Boutell v. Volk, 449 F.2d 673, 678 (10th Cir. 1971) the test was summarized as follows:

> "Blonder-Tongue . . . [simply held] that adjudication of invalidity of a patent following a full and fair hearing in which the defender of the patent had an adequate opportunity to present his case in support of validity would be final."

It is apparent from these quotations that there must be something more than proof of existence

of prior litigation of the same patent, resulting in an adjudication of infringement, before a patentee may be foreclosed from trial of a subsequent action involving the same patent. Under the principles announced, necessarily, there must be a balancing of the equities on a case by case basis.

Plaintiffs' first contention is that the District Court for the Southern District of Indiana, the Court of Appeals for the Seventh Circuit, and, by implications, the Supreme Court of the United States, when it denied certiorari, "wholly failed to grasp the technical matter and issues in suit." In the brief in this Court the plaintiffs state:

> "Those courts held plaintiffs' patent 'anticipated' by prior art dealing with feeder mechanisms; plaintiffs stand ready to prove the courts' misconception of the technical subject matter by proving that feeder mechanisms are machines radically different in structure, operation, and function from the bin activators to which plaintiffs' patent is actually directed. The District Court in this case, however, gave plaintiffs no chance to offer such proof; instead, by a process of reasoning wholly unrevealed, it held (App. 30) that the trial judge in the Carrier case made his conclusions of fact 'with an intelligent understanding of the technical issues involved'." Plaintiffs' brief, p.10.

Nothing is offered in support of this claim and the same issues were presented and disposed of in the appeal to the Seventh Circuit. Similarly, it was

claimed in the Seventh Circuit that Judge Steckler did not understand the invention. In disposing of that claim the Court of Appeals for the Seventh Circuit had the following to say:

> "Plaintiffs on brief state the contested issues as follows:
>
> > '1. Was it reversible error for the District Court to adopt the overly simplistic definition of the Wahl invention urged by defendant on the validity issue, and then predicate its finding of anticipation (by three separate items of prior art) and obviousness on that definition rather than on a fair reading of the Wahl claims in context?"
>
> * * *
>
> "It appears to us that issue 1 is stated in a rather novel manner. However stated, we think the ultimate issue is whether the court's findings of fact are clearly erroneous. Rule 52(a) of the Federal Rules of Civil Procedure provides in part:
>
> > 'Findings of Fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.'
>
> * * *

Decision

"The record refutes the suggestion that Judge Steckler was led astray. It reveals that he was keenly aware of the issues for decision and the contentions of the respective parties, and actively participated in the examination of the expert witnesses. He required each side to submit proposed findings and conclusions of law, upon which arguments were heard. At the conclusion of such arguments counsel for both sides were invited to the court's chambers for a discussion concerning the findings and conclusions of law proposed by defendant. The court required of defendant numerous changes in its proposal, as evidenced by the court's entry of August 6, 1969, 'Court met with counsel in chambers concerning the finalization of findings of fact and conclusions of law and indicated to counsel its objections to the proposed findings of fact and conclusions of law tendered by defendant and made suggestions for amendments thereof. Counsel for defendent is to prepare for submission to Court amended proposed findings of fact and conclusions of law and is to provide a copy to plaintiffs before filing the same with the Court.' Defendant's proposal, amended to meet the requirements of the court, was adopted on November 5, 1969." 452 F.2d at 98-99.

The Supreme Court in Blonder-Tongue pointed out that the occasions when trial courts and Courts of Appeals would fail to grasp the technical subject matter of the patent in suit would be "relatively

rare." 402 U.S. 333. In this case the District Court for the Western District of Kentucky and this Court have had available for examination the entire transcript and record of the litigation in the Southern District of Indiana, as well as the appendix filed on appeal with the Court of Appeals for the Seventh Circuit. The District Judge below examined the material available and concluded that Judge Steckler had an excellent grasp of the technical matters involved, that he applied the appropriate standards and that the plaintiff was afforded a clear opportunity to offer any and all available evidence. No claim is asserted in this Court that the plaintiffs have any additional or new evidence which they were prevented from presenting in the prior litigation.

In essence all that the plaintiffs' counsel claims is that he could have done a better job of cross-examining Dr. Fischer, the defendant's expert witness, than was done by plaintiffs' counsel in the Indiana litigation. Such a claim has little appeal to this Court. We recognize that any lawyer can by hindsight form opinions as to how he might have done a better job. We do not understand this to be the thrust of the crack in the door left by Blonder-Tongue. Plaintiffs presented criticism of Dr. Fischer's testimony to the Seventh Circuit Court of Appeals which disposed of that claim in the following manner:

> "Plaintiffs in their reply brief state that the district court did not 'understand the concept of Wahl's claimed invention and how it differs from the prior art,'

> and that he was 'deceived ...aided and abetted by a Professor Fischer, whose professorial charisma was relied on by defendant to legitimatize defendant's courtroom ploy.'
>
> * * *
>
> "It was that court's function, not ours on review, to weigh the conflicting testimony and judge of the credit to be given the witnesses. We are satisfied that the court properly performed its duty in this respect. Certainly we cannot hold that the finding was clearly erroneous under Rule 52(a)." 452 F.2d at 99, 102.

We, therefore, conclude that these plaintiffs "had a full and fair chance to litigate the validity of their patent" in the Southern District of Indiana.

In the Indiana litigation plaintiffs made the choice of the forum in which they desired to assert the validity of their patent. It appears from the record that Carrier Manufacturing Co., Inc., the defendant in the Indiana case, is a Kentucky corporation having its principal place of business at Jeffersonville, Indiana. Thus under the provisions of Title 28 U.S.C. §1391(c)[1], and Title

1. 28 U.S.C. §1391(c). "A corporation may be sued in any judicial district in which it is incorporated or licensed to do business or is doing business, and such judicial district shall be regarded as the residence of such corporation for venue purposes."

28 U.S.C. §1400(b)[2] the action could have been instituted in a District Court in Kentucky or in the District Court in Indiana. It may be that plaintiffs selected the Indiana forum because they had previously prevailed in patent litigation against the same defendant and involving similar machinery and technology before the same judge. 358 F.2d 1 (7th Cir. 1966). Presumably, the plaintiffs had no complaint about Judge Steckler's understanding of patent litigation at the time of the prior case.

We recognize that summary judgment, Rule 56, Rules of Civil Procedure, should be granted only in the exercise of great restraint. Poller v. Columbia Broadcasting System, Inc., 368 U.S. 464 (1962); C.F.W. Construction Co. v. Travelers Insurance Co., 363 F.2d 557 (6th Cir. 1966). However, summary judgment is proper where a trial would serve no useful purpose. Miller v. Western Board of Adjusters, Inc., 427 F.2d 175 (9th Cir. 1970); Applegate v. Top Associates, Inc., 425 F.2d 92 (2nd Cir. 1970); Bland v. Norfolk and Southern Railroad Co., 406 F.2d 863 (4th Cir. 1969); and as said by this Court in Rogers v. Peabody Coal Co., 342 F.2d 749, 751 (6th Cir. 1965):

> "It is clear that where a moving party supports his motion for summary judgment by appropriate means, which are uncontro-

2. 28 U.S.C. §1400(b). "Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business."

verted, the trial judge is fully justified in granting relief thereon."

Plaintiffs' counsel suggest in their briefs that they should have been accorded a trial for the purpose of determining whether or not the prior trial in the District Court in Indiana, which resulted in the adjudication of invalidity, awarded to the plaintiffs a full and fair opportunity under appropriate procedure to present all evidence and witnesses in support of the patent in suit. If we were to accept this theory the whole purpose of the rule laid down by the Supreme Court in Blonder-Tongue would be defeated. We, therefore, hold that such a trial is neither necessary nor advisable in a case such as this where the court in which the subsequent action is pending has available the record from the prior litigation from which it can determine whether the claim of estoppel rests upon a firm foundation based on the requirements laid down in Blonder-Tongue.

The judgments of the District Court is affirmed.

Appendix B

Memorandum and Order of United States District Court Western District of Kentucky (Filed April 24, 1972)

In The United States District Court

For The Western District of Kentucky
At Louisville

(Caption—Civil Action No. 6820)

MEMORANDUM AND ORDER
(Entered April 24, 1972)

This action for patent infringement is before the Court on motion of the defendant for summary judgment predicated upon a plea of collateral estoppel.

In a prior suit the validity of plaintiffs' patent was tested and, after an extensive trial, found to be invalid for obviousness. Wahl v. Carrier Manufacturing Company, Inc., 452 F.2d 9 (7th Cir., 1971). Subsequently, plaintiffs' writ of certiorari was denied by the Supreme Court on March 20, 1972.

Before final adjudication of the Indiana litigation, plaintiff commenced this action alleging infringement of his patent and seeking injunctive relief and damages.

The defendant in support of his motion relies entirely upon the recent Supreme Court decision, Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 U.S. 313,

28 L.Ed.2d 788, 91 S.Ct. 1434 (1971), which held that a Court determination of patent invalidity will operate as an estoppel in a subsequent suit by the same patentee against a different defendant so long as the patentee-plaintiff has had a full and fair opportunity to litigate the merits of his patent.

The plaintiff, in opposition, attempts to overcome the defense of estoppel by bringing the instant cause within the exceptions left open to patentees by the Supreme Court in Blonder-Tongue, Id. It is argued that collateral estoppel is only available to a defendant if, in the prior suit, patentee had a fair oportunity to procedurally, substantively and evidentually pursue his claim.

Here, patentee contends that the Indiana District Court improperly applied the standards announced in Graham v. John Deere Co., 383 U.S. 1, 15 L.Ed.2d 545, 86 S.Ct. 684 (1966); consequently, the Court's determination of obviousness was made incorrectly.

It is further argued that the trial and reviewing courts did not comprehend and understand the technical subject matter in issue; therefore, plaintiff should be given a second opportunity to prove the validity of their patent. As support for this argument patentee states that, at no fault of their own, they were deprived of an opportunity to present critical evidence of validity in the prior suit.

Although plaintiffs' numerous allegations concerning the prior suit, if proved, would successfully defeat the plea of estopppel, this Court, after careful examination of the records and authorities cited by both parties, concludes that no valid reason is advanced for not applying Blonder-Tongue, Id. Therefore, it is the conclusion of this Court that defendant's motion for summary judgment was correctly brought, and it will be upheld.

The record of the Indiana litigation does not support plaintiffs' argument that the trial court improperly applied the criteria of Graham v. John Deere Co., Id. An examination of the transcript demonstrates that the Court cited and followed those standards in determining obviousness or non-obviousness of plaintiffs' patent.

This cause does not appear to be one of those rare instants where the trial court failed to wholly understand and comprehend the technical issues in controversy. In fact, quite the contrary situation is presented. The Indiana suit lasted some eight days. During this time the trial Judge actively participated in the proof and his conclusions of fact were made an intelligent understanding of the technical issues involved.

Finally, plaintiffs argue that they were denied an opportunity to present crucial evidence and, had their counsel been more effective, then they would have prevailed in that suit.

This issue was recently decided in Bourns, Inc. and Marlan E. Bourns v. Allen-Bradley Co., No. 70 C 1992 (N.D. Ill., Feb. 1972). There, plaintiffs provided the Court with affidavits to demonstrate that they were deprived of critical evidence and witnesses at no fault of their own. The Illinois Court, in ruling against the patentee stated:

> "What plaintiffs really argue is that the attorneys (and plaintiffs) in the Nebraska lawsuit did not uncover all of the existing evidence during the seven years that the suit was pending.... If plaintiffs could demonstrate that the pending litigation was made possible by new facts or change of circumstances which did not exist at the time of the trial in 1969, their argument under this point might have merit. But as it is, the argument merely says that plaintiffs' attorneys in the present suit believe they could do better by a second effort."

Patentee fails to allege either new facts or change of circumstances which would justify a favorable decision on this issue.

The Supreme Court requires that cases of this type ultimately be decided by the trial court's sense of justice and equity. The facts reveal that plaintiff has been given a full and fair opportunity to litigate and prove the validity of his patent. As already noted, the previous trial lasted eight days and, at the conclusion of proof, patentee was given an additional nine months to offer additional rebuttal evidence. Upon losing

at the trial level, plaintiff appealed; he then had ample opportunity to present to the Seventh Circuit his arguments challenging the adverse decision rendered by the District Court. Plaintiff was unsuccessful and took his case to the Supreme Court where his writ was denied. It is obvious that to allow plaintiff to relitigate here, the same issues previously decided, would not serve justice and equity but would in fact have the contrary result.

Wherefore, It Is Ordered that the defendant's motion for summary judgment is sustained, and final Judgment will be entered accordingly.

April 20, 1972

/s/ Rhodes Bratcher
Rhodes Bratcher
United States District Judge

Copies to:
Counsel of record

* * * *

In The United States District Court
For The Western District of Kentucky
At Louisville

(Caption—Civil Action No. 6820)

JUDGMENT

(Entered April 24, 1972)

Memorandum and Order

This action came on before the Court, Honorable Rhodes Bratcher, United States District Judge, and a decision having been duly rendered, sustaining defendant's motion for summary judgment.

It is Ordered and Adjudged that the plaintiffs, Eugene A. Wahl and Vibra Screw, Inc., take nothing, and this action is dismissed at the cost of plaintiffs.

Dated at Louisville, Kentucky, this 24th day of April, 1972.

August Winkenhofer, Jr.
Clerk of Court

By: /s/ Rosemary Gorman
Deputy Clerk

Copies to counsel.

Appendix C

Decision of United States Court of Appeals for the Seventh Circuit (Filed August 30, 1971)

IN THE

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

SEPTEMBER TERM, 1970, APRIL SESSION, 1971

No. 18324
EUGENE A. WAHL and VIBRA SCREW FEEDERS, INC.,
Plaintiffs-Appellants,

v.

CARRIER MANUFACTURING CO., INC.,
Defendant-Appellee.

AUGUST 30, 1971

Appeal from the United States District Court for the Southern District of Indiana.

Before MAJOR, Senior Circuit Judge, and FAIRCHILD and PELL, Circuit Judges.

Decision

MAJOR, Senior Circuit Judge. This is an appeal from a judgment entered November 13, 1969, by Judge William E. Steckler, holding all four claims of United States Patent No. 3,173,583, entitled "Bin Activator," invalid, and dismissing plaintiffs' charge of infringement. Eugene A. Wahl (Wahl) is the owner of the patent and Vibra Screw Feeders, Inc. (Vibra Screw) is his exclusive licensee. The latter is a New Jersey corporation, and defendant Carrier Manufacturing Co., Inc. (now by change of name, Carman Industries, Inc.) is a Kentucky corporation having its principal place of business at Jeffersonville, Indiana.

After disposal of numerous discovery proceedings, the case came on for trial before the court without a jury on November 6, 1967, and continued on November 7, 8, 9, 10, 11, 13 and 14. On the last date and at the conclusion of defendant's presentation, the case, on plaintiffs' request, was continued to August 19, 1968, on which date plaintiffs introduced testimony purportedly for the purpose of rebutting the case made by defendant. As might be expected after a trial of such length, the record is voluminous. (The transcript covers some 1300 pages, and the appendix filed in this court more than 600 pages.) In addition, many physical exhibits were introduced, including the patent in suit, numerous prior art patents and many drawings, diagrams, pictures, etc., all explained by expert witnesses as an aid to the court in its evaluation of the contentions advanced by the parties.

Decision

The prior art relied upon by defendant to anticipate and invalidate the patent in suit was (1) the Heavy Duty Feeder made and sold by plaintiffs for several years prior to the Wahl application filing date; (2) the Vibra-Portioner[1] which was at one time made and sold by defendant, and (3) the Musschoot Patent No. 3,083,811. The court found that the patent in suit was anticipated by each of these prior art citations, none of which was cited in the Patent Office and all of which were found to be more pertinent than that which was cited.

The court also found that the subject matter sought to be patented by Wahl, in view of the prior art, would have been obvious at the time the invention was made, to a person having ordinary skill in the art to which the subject matter pertains, and was, therefore, invalid under Title 35 U.S.C.A. Sec. 103.

The court in its findings 6, 7 and 8 describes the nature of the Wahl invention and sets forth the claims involved. Inasmuch as there is no dispute as to the propriety of these findings, we adopt them:

> "6. The specification of the Wahl patent in suit generally describes the apparatus set forth therein as follows:
>
> 'This invention relates to apparatus

1. Carrier Patent No. 3,187,884 describes the Vibra-Portioner and may be considered as the same item of prior art.

for use in conjunction with a storage bin, or hopper, and more particularly to activator apparatus adapted for attachment to a storage bin to promote the flow of material therefrom.' (PXX-1, Col. 1, lines 6-10).

Also it is stated:

'An object of this invention is the provision of improved apparatus for use with a storage bin, or hopper, to promote a positive discharge of the contained material through the hopper discharge opening.' (PX-1, Col. 1, lines 43 to 46).

In the patent it is also stated:

'An object of this invention is the provision of apparatus for promoting the flow of material from a storage hopper having a discharge opening at the lower end thereof, which apparatus comprises a material-receiving member having sloping walls terminating in a material-dispensing opening, means vibratorily suspending the material-receiving member in alignment with the hopper discharge opening, means for vibrating the material-receiving member in a plane predominantly normal to the axis thereof, and means for imparting such vibrations to the contained material in the region of the hopper discharge opening.' (PX-1, Col. 1, lines 54 to 65).

Decision

"7. The Court finds that the application for the Wahl patent in suit was filed on May 9, 1962, and is a continuation-in-part of an earlier application filed April 4, 1962 which was abandoned. The original application contained only sheet 1 of the patent drawings, and, in general, the specification was directed to the structure shown in Figure 1 of the drawings. The continuation-in-part application added sheet 2 of the drawings, and added to the specification a description of the device shown in Figure 4 of the drawings. The structure shown generally in the Wahl patent comprises a supply hopper terminating in an opening at the bottom thereof and, attached by resilient supporting means to the hopper, there is a cross member which carries a motor or vibrating member to vibrate this cross member. Attached to the cross member is a material-receiving means which is vibrated with the cross member and which material-receiving means is positioned below the supply hopper. In both forms of the bin activator of the Wahl patent, that of Figure 1 and Figure 4, there is included as attached to the material-receiving means, a material-agitating means which is vibrated with the material-receiving means. In Figure 1, the material-agitating means comprises upstanding rods entering into the supply hopper, and these upstanding rods are attached to the material-receiving means and vibrated therewith. In Figure 4, there is a different form of

material-agitating means which comprises an upstanding rod secured to a bracket which is carried by the material-receiving means, and this upstanding rod adjustably supports a baffle which is positioned within the material-agitating means and at the outlet opening of the hopper. As stated in the specification, the material-receiving means supporting the material-agitating means by being resiliently supported from the hopper is vibrated by a motor, and upon vibration of the material-receiving means and the material-agitating means, the bulk material in the hopper is induced to flow therefrom.

"8. Plaintiff charges infringement of claims 1, 2, 3, and 4 of the patent in suit. Claims 2, 3 and 4 are dependent from claim 1. Claim 1 is as follows:

> '1. Apparatus for promoting the flow of material from a vertically-disposed storage bin having a discharge opening at the bottom, which apparatus comprises,
>
> (a) a generally-conical, material-receiving member having an inlet opening corresponding substantially to that of the bin discharge opening and a truncated apex forming an outlet opening,
>
> (b) means vibrationally supporting the conical member in a vertical position with the wall portion forming the inlet opening spaced from the bin wall,

(c) material-agitating means spaced from the inner wall of the conical member and rigidly secured thereto, said agitating means being disposed within said conical member and extending substantially to the said inlet opening thereof, and

(d) means vigorously vibrating the conical member.'

"Claim 2 calls for the invention of claim 1, but further defines the means for vibrating the conical member as a gyrator comprising an eccentrically-mounted weight rotatable by an electric motor. Claim 3 calls for the invention of claim 2, but defines the material-agitating means as a baffle member disposed in the region of the bin discharge opening. Claim 4 calls for the invention as recited in claim 2, and defines the material-agitating means as an inverted conical baffle member disposed in the region of the bin discharge opening, and further describes the vibration as in a plane normal to the axis of the conical member."

Plaintiffs on brief state the contested issues as follows:

"I. Was it reversible error for the District Court to adopt the overly simplistic definition of the Wahl invention urged by defendant on the validity issue, and then predicate its finding of anticipation (by three separate items of prior art) and obviousness on that

definition rather than on a fair reading of the Wahl claims in context?

"II. Was it reversible error for the District Court to adopt the unduly limited definition of the Wahl invention urged by defendant on the infringement issue, involving dimensional limitations nowhere mentioned in the Wahl patent, and then predicate its finding of non-infringement (as to some but not all of defendant's devices) on that definition rather than on a fair reading of the Wahl claims in context?"

It appears to us that issue I is stated in a rather novel manner. However stated, we think the ultimate issue is whether the court's findings of fact are clearly erroneous. Rule 52(a) of the Federal Rules of Civil Procedure provides in part:

> "Findings of Fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

The two principal witnesses were Wahl, the patentee, who testified at length in explaining his patent and his invention, or what he thought he had invented, and Don A. Fischer, an expert witness for defendant. We think it fair to state that a reading of the testimony of these two witnesses reveals that Wahl had much practical experience in the manufacture and development of apparatus designed to facilitate the withdrawal of material

from storage bins. It is conceded, however, that he was not an expert in reading and describing patent claims. On the other hand, Fischer lacked the practical experience of Wahl but was eminently qualified to interpret patent claims and the disclosure in connection therewith. He was an engineer, a former Dean of an engineering school, and a practicing attorney for six years, admitted to practice before the Patent Office. While the district court did not expressly so state, it is evident that in the main it rejected the testimony of Wahl and credited that of Fischer.

Plaintiffs, consistent with the nature of their presentation here, rely upon the testimony of Wahl and ignore that of Fischer; in fact, on brief they do not mention Fischer's name or refer to his testimony except on a point relative to the issue of infringement.

Plaintiffs in their reply brief state that the district court did not "understand the concept of Wahl's claimed invention and how it differs from the prior art," and that he was "deceived * * * aided and abetted by a Professor Fischer, whose professorial charisma was relied on by defendant to legitimatize defendant's courtroom ploy."[2]

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2. In a footnote they state that Fischer has given "expert testimony in patent cases about 45 times. It is apparent that no one is an expert in 45 different subjects." On the other hand, it is our thought that he must have proven his competency as an expert; otherwise, he would not have been so often called upon.

The record refutes the suggestion that Judge Steckler was led astray. It reveals that he was keenly aware of the issues for decision and the contentions of the respective parties, and actively participated in the examination of the expert witnesses. He required each side to submit proposed findings and conclusions of law, upon which arguments were heard. At the conclusion of such arguments counsel for both sides were invited to the court's chambers for a discussion concerning the findings and conclusions of law proposed by defendant. The court required of defendant numerous changes in its proposal, as evidenced by the court's entry of August 6, 1969, "Court met with counsel in chambers concerning the finalization of findings of fact and conclusions of law and indicated to counsel its objections to the proposed findings of fact and conclusions of law tendered by defendant and made suggestions for amendments thereof. Counsel for defendant is to prepare for submission to Court amended proposed findings of fact and conclusions of law and is to provide a copy to plaintiffs before filing the same with the Court." Defendant's proposal, amended to meet the requirements of the court, was adopted on November 5, 1969.

We hardly need cite cases in support of the rule that findings of fact of the trial court should not be set aside on review unless they are clearly erroneous. One case, however, Wahl v. Carrier Mfg. Co., Inc., 358 F.2d 1, a decision of this court, is of particular pertinency. In that case the action was brought by Wahl against Carrier for infringement of a "Power-Feeding Apparatus." The

trial court found the patent valid and infringed, and its findings were based largely on plaintiffs' expert testimony. The parties were the same as those here, the attorneys on both sides were the same, and the case was tried by the same trial judge. In affirming the judgment, we stated (page 3):

> "We agree with plaintiffs that like many patent infringement actions this one turns on ultimate technical facts the determination of which requires resolution of conflicts in the testimony of experts, and that the court's recognition of the difficulties inherent in arriving at findings in this technical area did not remove those findings, when made, from the scope of Rule 52(a).
>
> "Therefore, insofar as the detailed findings of the court, upon which it predicates its conclusions of validity and infringement, concern factual issues such as the use made of prior art, the nature of the improvement made over prior art, and the characteristics and operational functions of the patented structure and the accused apparatus, Rule 52(a) of the Federal Rules of Civil Procedure (28 U.S.C.A.) applies. The court heard the testimony of expert witnesses in connection with these matters and witnessed the demonstration of the physical exhibits, including the operation of the accused apparatus. The scope of our review of such findings is therefore limited to a determination of whether or not they are 'clearly erroneous.' Armour & Co. v. Wilson & Co.,

7 Cir., 274 F.2d 143, 151-157; Minnesota Mining and Mfg. Co. v. Technical Tape Corp., 7 Cir., 309 F.2d 55, 57; Aerosol Research Company v. Scovill Manufacturing Co., 7 Cir., 334 F.2d 751, 753. If they find support in the evidence we are bound thereby and there remains but the question of whether the court applied the correct legal criteria in reaching the ultimate conclusions it did."

Plaintiffs attempt to escape the potency of Rule 52(a) by arguing that we are in as good position to pass upon the validity of the patent in suit as was the district court. That argument is reiterated in the reply brief, "A reading of the District Court's Findings and Conclusions, the patent in suit and the three prior references held to be anticipations will provide this Court with all the essential facts it needs to review the District Court's holdings of invalidity."[3]

Cited in support of this argument are two decisions of this court, Charles Peckat Mfg. Co. et al. v. Jacobs, 178 F.2d 794, and Nasco Incorporated v. Vision-Wrap, Inc., 352 F.2d 905. The situation in those cases was a far cry from that here. In Peckat, there was no parol testimony upon the issue of anticipation by the prior art, and we held that we were in as good position

3. Plaintiffs attached to their reply brief a chart submitted, so it is asserted, to clarify plaintiffs' argument to this court. It supposedly illustrates the Wahl device, defendant's competing device, and the prior art devices. There is no showing as to who prepared the chart, or when, but admittedly it was not an exhibit in the district court.

to interpret the patent and those relied upon to anticipate as was the trial court. In Nasco, we had a similar situation and stated (page 908):

> "The defendant offered no testimony, expert or otherwise, on the prior patent art. The appealed decision rests entirely on documentary evidence and physical exhibits. Consequently, the court's findings, in so far as they concern the use made of prior art, the nature of the improvement made over prior art, and the operational functions and characteristics of the patented structure and the accused device, are deprived of the degree of finality which would otherwise attach under Rule 52(a) of the Federal Rules of Civil Procedure (28 U.S.C.A.). We are in as good a position as the trial court to examine and evaluate the evidence and make the necessary determinations ourselves."

In marked contrast, the court in the instant case heard voluminous testimony in a trial which lasted eight days. Both Wahl and Fischer in their capacity as experts testified in great detail in explanation of the many physical exhibits, including the patent in suit, the prior art cited in the Patent Office, and that not cited but relied upon by defendant and held by the court to anticipate.[4]

4. The transcript contains some 1294 pages of which 582 pages are devoted to the testimony of Wahl, and 270 pages to that of Fischer. Thus, about two-thirds of the transcript is devoted to the testimony of these two witnesses.

Decision

Plaintiffs' contention that the trial court did not understand the Wahl invention and, therefore, erroneously found that it was anticipated by prior art disclosures is predicated mainly on the testimony of Wahl, ignoring that of Fischer, defendant's expert witness. It would prolong this opinion beyond any permissible length to set forth all of the court's findings on this phase of the case; therefore, we shall quote only the finding with reference to the Heavy Duty Feeder made and sold by Plaintiffs. The court found:

> "10. The facts concerning the Wahl heavy duty feeder:
>
> > "(a) It is conceded that Vibra Screw sold a heavy duty feeder more than one year prior to the filing of the original application for the Wahl patent. This heavy duty feeder is shown in defendant's Exhibits AA-1, B, C, D and E. As stated in defendant's Exhibit A-1, one of the purposes of the vibrating portion of the heavy duty feeder is to provide a vibrating baffle plate attached to a feeder trough which constitutes a material-receiving member, and the vibrating baffle plate enters the supply bin to transmit vibration directly into the material, facilitating the flow of material from the supply bin into the feeder. Although this device included a feeder for the volumetric discharge of material from a supply hopper, essentially there is shown in the heavy duty feeder, a material-receiving member positioned below a supply hopper, a

vibrated material-receiving member which carries a vibrated material-agitating means positioned within the material-receiving member, and which material-agitating means is positioned adjacent the discharge outlet of a hopper, and upon vibration induces the flow of material therefrom. In function and in structure, the vibrating portions of the heavy duty feeder are substantially identical with the structure shown in Figure 4 of the Wahl patent in suit.

"(b) During the course of the trial, Mr. Wahl, plaintiff and owner of the patent here in suit, referred to a difference between the heavy duty feeder and the bin activator shown in his patent, stating that the heavy duty feeder was intended only for use with small bins or hoppers, whereas, his bin activator was intended for use primarily with large hoppers. The Court finds that the specification of the Wahl patent and the claims do not state that the bin activator is intended for use primarily with large hoppers. Wahl conceded that the bin activator of the patent in suit could be applied to very small bins, and that under these circumstances, either the bin activator or heavy duty feeder could be used to induce the flow of material from the bin. Furthermore, the literature issued by Vibra Screw (Exhibit D) relating to the heavy duty feeder states: 'Designed for tonnage

rates, it connects to any supply pipe or hopper and will consist flow of material out of such hoppers.'

"(c) The Court finds that the Wahl heavy duty feeder contains the elements of the claims of the patent in suit. Although element (a) is in the claim defined as a generally conical material-receiving member, the specification of the patent, in Col. 5, states that this material-receiving member may be conical, square, rectangular, or any other shape to conform to a particular hopper shape. The material-receiving member of the heavy duty feeder is therefore the equivalent of the generally conical material-receiving member called for in claim 1.

"(d) The Court finds that the claims of the patent in suit may be read on the structure of the heavy duty feeder, and that none of the prior art cited by the Patent Office is as pertinent to the invention claimed in the Wahl patent as the Wahl heavy duty feeder. If the Patent Office, during the prosecution of the application for the Wahl patent, had before it the drawing of the heavy duty feeder (Exhibit B), with the knowledge that the device was on sale in 1959, the Patent Office would not, in the opinion of the Court, have granted any claims in the Wahl application.

"(e) The file history of the application for the patent in suit discloses that the existence of the heavy duty feeder was not called to the attention of the Patent Office."

It will be noted that paragraphs (a) and (b) of this finding are based largely upon concessions made by Wahl during his cross-examination, while paragraphs (c), (d) and (e) are based on the testimony of Fischer.

Fischer testified that the claims of the patent read directly on the Vibra Screw Heavy Duty Feeder as illustrated by Exhibit B, and that all of the elements function in the same way to produce the same result as the device of the patent in suit. He pointed out that during the prosecution of the application for the Wahl patent there was no disclosure to the Patent Office by Wahl of the existence of the Vibra Screw Heavy Duty Feeder and the fact that it had been on sale by plaintiffs more than one year prior to the filing of the application for the Wahl patent. He also testified that none of the prior art cited by the Patent Office was as pertinent to the invention claimed in the Wahl application as the device illustrated in Exhibit B, and that in his opinion if the Patent Office had before it the drawing of Exhibit B with the statement that the device was on sale in 1950, the Patent Office would not have granted the claims of the Wahl patent.

Thus, the trial court was confronted with the testimony of two knowledgeable witnesses who in some respects were in wide disagreement as to what Wahl had invented, as disclosed by his patent, and the disclosure of the prior art. It was that court's function, not ours on review, to weigh the conflicting testimony and judge of the credit to be given the witnesses. We are satisfied that the court properly performed its duty in this respect. Certainly we cannot hold that the finding was clearly erroneous under Rule 52(a).

The court found that Wahl's patent was anticipated by the Vibra-portioner manufactured and sold by defendant, and by Carrier Patent No. 3,187,884, issued to defendant. While the court made a separate finding as to each of these items, the patent discloses and illustrates the Vibra-Portioner and, as stated in plaintiffs' brief, "* * * these items of prior art are properly treated as one item." Plaintiffs' principal point is that the material-receiving means of the Wahl invention were not disclosed by these items of prior art. Plaintiffs state on brief, "As stated several times herein, the shape and location of the material-receiving member is crucial to the invention."

On this phase of the case, as well as on many others, the testimony of the experts as to what was shown by Wahl and the prior art under discussion was conflicting. For instance, Wahl testified:

"A. The Carrier Patent does not have a material-receiving member coincident with the compaction zone which in this case, as in all other conical members, lies toward the outlet of the conical member.

Q. [By Mr. Brown] Can you tell us where that is in relation to the reference numerals?

A. That would be just above numeral 32-let us say we are now talking about the hopper designated by number 31, the outlet of the hopper I believe is number 32 and the compaction zone lies just above the * * *

Q. Mr. Wahl, what measures do you find Carrier Patent teaches in connection with relieving problems of flow at that particular zone?

A. The only thing Carrier uses there is a vibrating baffle similar to that which appears in the Wahl Heavy Duty Feeder."

On the other hand, Fischer testified:

"Q. Are you able, then, in your interpretation of claim 1 of the Wahl patent in suit, to find in the Carrier patent, all of the elements of the claim?

A. Yes, I did.

Q. Do those elements, as set forth in the Carrier patent, operate in substantially the same manner to produce substantially the same result as the bin activator of the Wahl patent?

A. Yes, they do. The material-agitating means vibrates the material and it flows

> out of the top receptacle into the material-receiving member that also vibrates the material, and the material comes out of chutes from the material-receiving member."

He also testified that in his opinion if the Patent Office had had before it prior art such as the Carrier patent, it would not have granted the claims of the Wahl patent.

The court found that Wahl's invention was anticipated by Musschoot Patent No. 3,083,811, issued April 2, 1963. Plaintiffs argue that like all other items of prior art found by the district court to anticipate, there is not found in Musschoot a "general-conical material-receiving member," as disclosed by Wahl. Plaintiffs' argument as to Musschoot, as it is to all other prior art found to anticipate, relies upon the testimony of Wahl and ignores that of Fischer. The latter testified in detail in comparing Musschoot with Wahl as the basis for his conclusion that all of the elements set forth in the Wahl patent were found in the disclosure of Musschoot, and that the structure shown performed the same function as the Bin Activator in Wahl.

To hold, as plaintiffs would have us do, that the court's findings that Wahl's Heavy Duty Feeder, defendant's Vibra-Portioner (Carrier patent No. 3,187,884), and the Musschoot patent did not anticipate Wahl would require us to conclude that the trial judge improperly gave credit and weight to the testimony of Fischer. We recognize that

plaintiffs' argument on this score is not without plausibility, but we assume it was made to the trial court and rejected. It was the function of that court to resolve the conflict in the testimony, and we cannot hold that its resolution was clearly erroneous.

Title 35 U.S.C.A. Sec. 103 provides that a patent may not be obtained "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

The court (finding 15) found:

> "The differences between the subject matter sought to be patented in the Wahl patent and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

The court in paragraph (b) of finding 15 found:

> "The Court finds from the record in this case, and the prior art devices referred to above, that at the time the Wahl asserted invention was made the art of vibration to induce material to flow from a hopper was well known. The level of the skill at that time was such that it was known, or obvious,

to a person of ordinary skill in the art to induce flow from a hopper by the use of a vibrating material-receiving means which carries a vibrating agitating means positioned within a hopper adjacent to the outlet end of a hopper or just below the discharge end of a hopper, whereby the simultaneous vibration of the material-agitating means and material-receiving means would induce flow of hard-to-handle material from the hopper, thus preventing the bridging or arching of material within the hopper. The witness Dumbaugh, an employee and officer of defendant corporation, testified that he was first employed by defendant on August 1, 1962 when the corporation had few employees, and that his prior experience did not include any information relative to bin activators, feeders or other vibrating devices. Upon becoming employed by defendant, his initial project was to improve the Vibra-Portioner, then being sold by defendant, and without any experience in the vibrator field, and within a matter of 6 weeks, he had developed a device substantially identical with that shown in the Wahl patent, functioning in the same way to produce the same result. The Court finds from this evidence it is established that to a person of less than ordinary skill in the art, the device shown and described in the Wahl patent, functioning in the same way to produce the same result, could be developed within a relatively short period of time from the time the problem was first encountered."

Decision

The court also found (finding 16):

> "There is an assertion that defendant's accused vibrating hoppers were copied from plaintiffs' commercial device, and the Court finds as a fact, that Dumbaugh, an employee of defendant corporation, completed the design of the prototype, which ultimately became defendant's feeders, as early as September 16, 1962, when he modified the Vibra-Portioner then being sold by defendant. Prior to this time he had not seen any of the literature issued by plaintiff. Some reference has been made to the proposed sale by plaintiff of a feeder to the Austin Company, but the Court finds, as a fact, that the first contact defendant had with the Austin Company job was November 9, 1962, after defendant had completed its modified version of its Vibra-Portioner. The hoppers made by defendant herein charged to infringe were developed independently by defendant."

There is no question but that Dumbaugh testified as the court found. Plaintiffs, with some plausibility, attack the testimony of this witness as incredible. Again, however, credibility of the witness and the weight to be given his testimony was a matter for the trier of the facts.

In Graham et al. v. John Deere Co., et al., 383 U.S. 1, the court in discussing the factors relevant to the issue of obviousness stated (page 17):

> "Under Sec. 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness of nonobviousness, these inquiries may have relevancy."

See also our decision in Akron Brass Co. v. Elkhart Brass Mfg. Co., 353 F.2d 704, 706.

The court was not unmindful of plaintiffs' reliance upon commercial success, as shown in its conclusion of law:

> "Although plaintiffs have established some commercial success of the devices covered by the patent in suit, such commercial success cannot in a case such as this, render valid a patent otherwise invalid. In any event, commercial success may be used only where there is some doubt as to the validity of a patent. Good and valid

> patents do not need commercial success to sustain them. Invalid patents cannot be helped by commercial success."

In connection with Dumbaugh's solution of the problem of discharging materials from an upper bin, the statement of this court in Novo Industrial Corp. v. Standard Screw Co., 374 F.2d 824, 828, is pertinent:

> "The development of the valve of the patent in suit, and the independent and almost contemporaneous development and introduction of the defendant's accused valve structure which followed, in our judgment warrant the conclusion that the structure of the patent in suit was but the result of application of ordinary skill in the art to a problem which for the first time was beginning to assume significant commercial importance to the automotive industry."

The court's finding on the issue of obviousness also finds support in the testimony of defendant's expert, Fischer, who as a university professor of engineering for some three years, frequently submitted problems to the students for solution as a part of their training program. After relating his experience with his students, particularly those who had about completed their engineering course, he concluded his testimony as follows:

"Q. Then my question is would the solution to the problem as proposed by Wahl in his patent have been obvious to a person having ordinary skill in the art?

A. In my opinion it certainly would. And I also base this on what it states in the Musschoot patent about arching and how to break up arching."

We find no reason to reject the court's finding on the issue of obviousness, and it follows that it correctly held as a matter of law that the Wahl patent was invalid for that reason.

We now consider Carrier Reissue Patent No. 26,291, issued October 31, 1967, with claims 7, 8, 9 and 10, which thereby became additional to those originally in Carrier Patent No. 3,187,884. The court in finding 17 relative to the reissue patent preliminarily stated that it "plays a very important role in the consideration of this case." We disagree with this statement and think its role is minor, in fact, of little if any consequence. On October 14, 1969, on defendant's application, the Patent Office allowed a disclaimer of all claims of the reissue patent, thereby effectively removing them from the case. See Soundscriber Corp. v. United States, 360 F.2d 954, 961 (U.S. Court of Claims); In Application of Heinle, 342 F.2d 1001, 1006 (U.S. Court of Customs and Patent Appeals). This disclaimer was allowed about a month prior to the entry of the judgment in this case and we are not advised if the court was aware of the disclaimer.

Decision

Counsel for defendant late in the trial did suggest "that these claims granted in the reissue patent are probably invalid because of the information we discovered from Mr. Wahl concerning his own bin feeder. * * * But what this does is to tie the earlier Carrier Patent, the earlier Exhibit B bin activator—or heavy duty feeder of Mr. Wahl, the subject matter of the Wahl Patent, all in the same category with the Carrier Patent and its disclosure preceding that which is shown in the Wahl Patent. * * * The Patent Office, as it has now done, could have granted that claim to Carrier. Carrier would then have the patent, Wahl would not; Carrier would be suing Wahl for infringement."

We strongly suspect that it was the strategy of defendant's counsel to inject these reissue claims into the case in an attempt to obtain a finding that the Carrier patent was valid, or at least an expression by the court to that effect. This latter, as subsequently shown, it succeeded in doing. No issue as to the validity of Carrier was before the court, and we think it was error to make a finding or express an opinion on that score.

Defendant on brief explains the reason for its disclaimer of the reissue claims, as follows, "It has been concluded that since Wahl made and sold these heavy duty feeders in 1959 and 1960, these heavy duty feeders stand as a prior use bar to the valid grant to defendant of the claims added by reissue. In effect, insofar as the material-agitating means of plaintiff's heavy duty feeder are concerned, they are substantially equated with

the same elements in the Carrier patent. (Emphasis supplied.) For this reason, the claims added to the Carrier patent by reissue have now been disclaimed and the action is completely consistent with the position of defendant in this case to the effect that not only is the structure of the Carrier patent a complete anticipation of the claims of Wahl's bin activator, but also plaintiffs' heavy duty feeder is likewise a complete anticipation."

This explanation engenders more confusion than light. The court had previously found (finding 10(c)) "that the Wahl heavy duty feeder contains the elements of the claims of the patent in suit," and for that reason anticipated. The court had also previously found (finding 11 (d)), referring to the material-receiving means of Carrier, "* * * the structure and the function of this portion of the device is substantially identical to the structure and function of the device shown in Figure 4 of the Wahl patent in suit." In finding 11(e) the court had found "that the device of the Carrier patent has all of the elements of claim 1, with these elements functioning substantially in the same way to produce substantially the same result in the same way as the device of the patent in suit."

Thus, defendant's explanation leads to the conclusion that while Carrier disclosed all of the elements of Wahl and the latter was anticipated by its Heavy Duty Feeder, Carrier was left unscathed by the same prior art. Admittedly, Wahl's Heavy Duty Feeder was prior art to Carrier, as it was to Wahl.

The court also previously found (finding 13) that the Musschoot patent contained all of the basic elements of the claims in Wahl and "these elements in the Musschoot device function in the same way as the bin activator in the Wahl patent to produce substantially the same results." Musschoot was prior art to Carrier, as it was to Wahl.

As stated by defendant's counsel before the trial court, the original Carrier patent and Wahl's Heavy Duty Feeder (the subject matter of the Wahl patent) fall in the same category.

The court in its finding relative to the reissue claims made no mention of the fact that they had been disclaimed on the basis of the disclosure made in Wahl's Heavy Duty Feeder and were no longer in the case.

Paragraph (a) describes the procedure followed by Carrier in obtaining the reissue claims. Paragraph (b) points out that both the Carrier and Wahl patents were pending in the Patent Office at the same time and that no interference was declared. Paragraph (c) states:

> "(c) Based upon the record in this case, it is the Court's opinion that, if the Patent Office had declared an interference between the application for the Carrier patent and the application for the patent in suit, Carrier should have been determined to be the prior inventor, and the claims directed to the common subject matter,—i.e., the concept of

providing a material-receiving means vibrationally supporting a material-agitating means positioned below a supply hopper would have been awarded to Carrier, and no claims would have been awarded to Wahl."

In our view, this is not a finding of fact, but is argumentative in nature and based on speculation. We do not know what the Patent Office would have done if an interference had been declared, and we doubt if Judge Steckler or defendants' expert witness could have known. Either party could have called for an interference. If Carrier, whose application for patent was filed prior to that of Wahl, had thought that its disclosure duplicated Wahl, it seems reasonable to believe that it would have called for an interference. Its failure to do so raises an inference that it had no such notion at the time the two patents were pending, and that the theory now advanced was evolved in preparation for this law suit.

Paragraph (d) states:

"(d) The fact that the Patent Office granted the Carrier reissue patent with claims dominating the structure shown in the Wahl patent in suit is evidence that the Patent Office, with its expertise, considers that the subject matter disclosed in the original Carrier patent is substantially identical with the disclosures in the Wahl patent in suit."

Again, we think this finding is more argumentative than factual. If, however, the subject matter disclosed in Carrier was substantially identical with that in Wahl, it was also substantially identical with the disclosure of Wahl's Heavy Duty Feeder found to anticipate Wahl and prior art to both Wahl and Carrier. While there may be some portions of the finding on this issue which are tenable, we think considered as a whole it is clearly erroneous for the reasons stated.

The court after finding the patent invalid proceeded to make findings concerning the alleged infringement of the claims, if valid, by various devices made and sold by defendant. Plaintiffs offered in evidence an exhibit which disclosed the drawings of defendant's alleged infringing devices. The court, for reasons subsequently shown, divided such devices into two categories and found some to infringe and others not.

Defendant in defense of the infringement charge relies upon the doctrine of file wrapper estoppel, a theory thoroughly embedded in the law. Among the numerous cases cited we need mention only Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126, and the recent decision of this court in Taylor-Reed Corp. v. Mennon Food Products, Inc., 324 F.2d 108. The theory is aptly stated by this court in Taylor-Reed (page 113):

> "The applicant having limited his claim by amendment and accepted a patent, brings himself within the rules that if the claim to a combination be restricted to specified elements, all must be regarded as material,

and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers."

There is no dispute as to the circumstances relied upon by defendant as constituting file wrapper estoppel. As the court found, the original claims filed by Wahl were rejected over the prior art for the reasons that there was no specific location for the material-agitating means with respect to the conical member. Specifically, the court found:

> "By a Patent Office rejection of January 28, 1964, the Examiner rejected this claim for the reason that the location of the agitating means was recited so broadly that it read upon one of the elements of the prior art Rouse patent. After this rejection, this claim was amended to locate the agitating means as 'being disposed within said conical member and extending substantially to the said inlet opening thereof.' The Court finds that in order to avoid prior art, the agitating means was specifically located as being within the conical member and extending substantially to the said inlet opening thereof." (Emphasis supplied.)

The court further found:

> "(c) The vibrating hoppers sold by both plaintiff and defendant have the material-agitating means located at varying positions

with respect to the inlet opening. Sometimes the apex of the cone or baffle, which constitutes the material-agitating means, is positioned substantially below the inlet opening, and in other devices, this material-agitating means is positioned substantially below the inlet opening of the cone member or material-receiving means. In the light of the prosecution history, and the file wrapper estoppel just referred to, the Court finds there is infringement of these claims only if the apex of the cone or the material-agitating means comes within one inch of the inlet opening. There are some such devices made and sold by defendant, and if the claims are valid, such devices infringe the claims of the patent in suit." (Emphasis supplied.)

The court concluded:

"Athough an invalid patent may not be infringed, the Court finds that if the claims of the patent in suit are valid they are infringed only by each of the devices made and sold by defendant wherein the apex of the cone or material-agitating means comes within one inch of the inlet opening of the vibrating material-receiving means, and this finding is based upon the file wrapper estoppel heretofore referred to." (Emphasis supplied.)

Thus, the issue on this facet of the case is whether the requirement that the agitating means be located as "extending substantially to the said inlet opening thereof" (the conical member), in-

serted in the claims in order to secure their allowance over the prior art, can reasonably be interpreted to be met only if such means "comes within one inch of the inlet opening," as interpreted and found by the court.

Plaintiffs argue that this dimensional limitation is arbitrary and devoid of all realism. They argue, as Wahl indicated in his testimony, that "extending substantially" to the inlet opening could as well be interpreted as meaning a location at any point in the upper half of the cone, as contrasted with the lower half.

The fallacy of plaintiff's argument on this point is that it is without substantial support in the evidence. Only Wahl and Fischer testified as to the interpretation to be given to the phrase, "within one inch of the inlet opening." Fischer reviewed the file wrapper history, including the circumstances under which Wahl's claims were allowed, a reading of which discloses that he had a substantial basis for his opinion that the dimensional limitation of one inch was proper.

On the other hand, Wahl's testimony as to his interpretation of the claims of his patent in the light of the prosecution history and what he considered to be an infringement, specifically with reference to the material-receiving means, was confusing and uncertain. He expressed the view that it could be at any point within six inches or one foot from the inlet opening. His confusion in this respect is shown by his testimony:

"Q. Now, each time you have notified a customer that Carrier, in your opinion, is infringing the claims of the patent in suit, have you known specifically which device Carrier was proposing to sell to that customer?

A. We didn't particularly concern ourselves about which device. So far as we are concerned, both devices are take-offs from our bin activator.

Q. Do they come within the claims of the patent?

A. We think they do.

Q. Regardless of the position of the cone?

A. That's right.

Q. Even if the cone is adjacent to the base outlet of the vibrating member?

A. Yes."

The court was required to interpret the phrase, "extending substantially to the said inlet opening." This must have presented a perplexing problem, but it is not discernible how the court could have made such determination except by utilizing the evidence before it. As stated, the only positive testimony was the opinion of Fischer, and we cannot hold that the court erred in basing its finding and conclusion thereon. It follows that defendant's devices wherein the apex of the cone comes within one inch of the inlet opening of the vibrating material-receiving means, infringe; otherwise, they do not.

Finally, plaintiffs argue that if the agitating means were lowered from one inch below the inlet to halfway down from the inlet, the combination would function in substantially the same way to obtain substantially the same result. This argument is based on the doctrine of equivalents, and, if accepted, would emasculate or negate the doctrine of file wrapper estoppel. We know of no authority, and doubt if there is any, which would support this argument.

The judgment of the district court adjudicating and decreeing the claims of the patent in suit invalid and dismissing plaintiff's complaint for infringement thereof is

AFFIRMED.

Appendix D

Findings of Fact and Conclusions of Law – United States District Court Southern District of Indiana Dated November 5, 1969

1. Plaintiff, Eugene A. Wahl, is the owner of United States Patent No. 3,173,583.

2. Plaintiff, Vibra Screw Feeders, Inc., a New Jersey corporation, is the exclusive licensee under United States Patent No. 3,173,583.

3. Defendant, Carrier Manufacturing Co., Inc. (now by change of name, Carman Industries, Inc.), is a Kentucky corporation having its principal place of business at Jeffersonville, Indiana.

4. This Court has jurisdiction of this cause of action because it arises under the Patent Statutes of the United States.

5. By the Complaint herein, defendant is charged with infringement of claims 1, 2, 3 and 4 of patent No. 3,173,583, and defendant alleges that the claims of the patent are invalid and that it has not infringed any of the claims of the patent.

6. The specification of the Wahl patent in suit generally describes the apparatus set forth therein as follows:

> "This invention relates to apparatus for use in conjunction with a storage bin, or hopper, and more particularly to activator apparatus adapted for attachment to a storage bin to promote the flow of material therefrom." (PX-1, Col. 1, lines 6-10).

Also, it is stated:

> "An object of this invention is the provision of improved apparatus for use with a storage bin, or hopper, to promote a positive discharge of the contained material through the hopper discharge opening." (PX-1, Col. 1, lines 43 to 46).

In the patent it is also stated:

> "An object to this invention is the provision of apparatus for promoting the flow of material from a storage hopper having a discharge opening at the lower end thereof, which apparatus comprises a material-receiving member having sloping walls terminating in a material-dispensing opening, means vibratorily suspending the material-receiving member in alignment with the hopper discharged opening, means for vibrating the material-receiving member in a plane predominantly normal to the axis thereof, and means for imparting such vibrations to the contained material in the region of the hopper discharge opening." (PX-1, Col. 1, lines 54 to 65).

7. The Court finds that the application for the Wahl patent in suit was filed on May 9, 1962, and is a continuation-in-part of an earlier application filed April 4, 1962 which was abandoned. The original application contained only sheet 1 of the patent drawings, and, in general, the specification was directed to the structure shown in

Figure 1 of the drawings. The continuation-in-part application added sheet 2 of the drawings, and added to the specification a description of the device shown in Figure 4 of the drawings. The structure shown generally in the Wahl patent comprises a supply hopper terminating in an opening at the bottom thereof and, attached by resilient supporting means to the hopper, there is a cross member which carries a motor or vibrating member to vibrate this cross member. Attached to the cross member is a material-receiving means which is vibrated with the cross member and which material-receiving means is positioned below the supply hopper. In both forms of the bin activator of the Wahl patent, that of Figure 1 and Figure 4, there is included as attached to the material-receiving means, a material-agitating means which is vibrated with the material-receiving means. In Figure 1, the material-agitating means comprises upstanding rods entering into the supply hopper, and these upstanding rods are attached to the material receiving means and vibrated therewith. In Figure 4, there is a different form of material-agitating means which comprises an upstanding rod secured to a bracket which is carried by the material-receiving means, and this upstanding rod adjustably supports a baffle which is positioned within the material-agitating means and at the outlet opening of the hopper. As stated in the specification, the material-receiving means supporting the material-agitating means being resiliently supported from the hopper is vibrated by a motor, and upon vibration of the material-receiving means and the material-agitating means,

the bulk material in the hopper is induced to flow therefrom.

8. Plaintiff charges infringement of claims 1, 2, 3 and 4 of the patent in suit. Claims 2, 3 and 4 are dependent from claim 1. Claim 1 is as follows:

> "1. Apparatus for promoting the flow of material from a vertically-disposed storage bin having a discharge opening at the bottom, which apparatus comprises,
>
> (a) a generally-conical, material-receiving member having an inlet opening corresponding substantially to that of the bin discharge opening and a truncated apex forming an outlet opening,
>
> (b) means vibrationally supporting the conical member in a vertical position with the wall portion forming the inlet opening spaced from the bin wall,
>
> (c) material-agitating means spaced from the inner wall of the conical member and rigidly secured thereto, said agitating means being disposed within said conical member and extending substantially to the said inlet opening thereof, and
>
> (d) means vigorously vibrating the conical member."

Claim 2 calls for the invention of claim 1, but further defines the means for vibrating the conical member as a gyrator comprising an eccentrically-mounted weight rotatable by an electric motor. Claim 3 calls for the invention of claim 2, but defines the material-agitating means as a baffle member disposed in the region of the bin discharge opening. Claim 4 calls for the invention as recited in claim 2, and defines the material-agitating means as an inverted conical baffle member disposed in the region of the bin discharge opening, and further describes the vibration as in a plane normal to the axis of the conical member.

9. Defendant alleges that the claims of the Wahl patent are invalid because anticipated by a prior use device described as the "Wahl heavy duty feeder," by Carrier Patent No. 3,187,884, by defendant's prior use device known as the "Vibra-Portioner" and the Musschoot Patent No. 3,083,811. Alternately, defendant asserts that if these prior art devices and prior art patent do not specifically contain all of the elements of the claims of the Wahl patent, then under Title 35 USC, Sec. 103, the differences, between the subject matter sought to be patented in the Wahl patent and the above cited prior art are such that the subject matter as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which this subject matter pertains.

10. The facts concerning the Wahl heavy duty feeder:

Findings and Conclusions

(a) It is conceded that Vibra Screw sold a heavy duty feeder more than one year prior to the filing of the original application for the Wahl patent (R. 30-32). This heavy duty feeder is shown in defendant's Exhibits AA-1, B, C, D and E. As stated in defendant's Exhibit A-1, one of the purposes of the vibrating portion of the heavy duty feeder is to provide a vibrating baffle plate attached to a feeder trough which constitutes a material-receiving member, and the vibrating baffle plate enters the supply bin to transmit vibration directly into the material, facilitating the flow of material from the supply bin into the feeder. Although this device included a feeder for the volumetric discharge of material from a supply hopper, essentially there is shown in the heavy duty feeder, a material-receiving member positioned below a supply hopper, a vibrated material-receiving member which carries a vibrated material-agitating means position within the material-receiving member, and which material-agitating means is positioned adjacent the discharge outlet of a hopper, and upon vibration induces the flow of material therefrom. In function and in structure, the vibrating portion of the heavy duty feeder are substantially identical with the structure shown in Figure 4 of the Wahl patent in suit.

(b) During the course of the trial, Mr. Wahl, plaintiff and the owner of the patent here in suit, referred to a difference between the heavy duty feeder and the bin activator

shown in his patent, stating that the heavy duty feeder was intended only for use with small bins or hoppers, whereas, his bin activator was intended for use primarily with large hoppers. The Court finds that the specification of the Wahl patent and the claims do not state that the bin activator is intended for use primarily with large hoppers. Wahl conceded that the bin activator of the patent in suit could be applied to very small bins, and that under these circumstances, either the bin activator or heavy duty feeder could be used to induce the flow of material from the bin (R. 276-79). Furthermore, the literature issued by Vibra Screw (Exhibit D) relating to the heavy duty feeder states: "Designed for tonnage rates, it connects to any supply pipe or hopper and will assist flow of material out of such hoppers."

(c) The Court finds that the Wahl heavy duty feeder contains the elements of the claims of the patent in suit. Although element (a) is in the claim defined as a generally conical material-receiving member, the specification of the patent, in Col. 5, states this material-receiving member may be conical, square, rectangular, or any other shape to conform to a particular hopper shape. The material-receiving member of the heavy duty feeder is therefore the equivalent of the generally conical material-receiving member called for in claim 1.

(d) The Court finds that the claims of the patent in suit may be read on the structure of the heavy duty feeder, and that none of the prior art cited by the Patent Office is as pertinent to the invention claimed in the Wahl patent as the Wahl heavy duty feeder. If the Patent Office, during the prosecution of the application for the Wahl patent, had before it the drawing of the heavy duty feeder (Exhibit B), with the knowledge that the device was on sale in 1959, the Patent Office would not, in the opinion of the Court, have granted any claims in the Wahl application (R.876-877).

(e) The file history of the application for the patent in suit discloses that the existence of the heavy duty feeder was not called to the attention of the Patent Office.

11. The facts with respect to Carrier patent No. 3,187,884:

(a) This patent was issued June 8, 1965 after the date of issue of the patent in suit, but was based upon an application filed January 26, 1962, prior to the date of filing of the original Wahl application.

(b) Carrier patent No. 3,187,884 (Exhibit KK) is owned by defendant and is prior art to the patent in suit because in the record of this case, Wahl was not able to establish a date of invention for the subject matter of his application as early as January 26, 1962.

Findings and Conclusions

(c) The Carrier patent discloses a device which includes a supply hopper supported on vertical supports attached to a base. Under the hopper is a feeder which receives material from the hopper. Extending from this material-receiving means and fixed to it by a rod is a baffle which is vibrated simultaneously with the vibration of the material-receiving means. In operation, material is put into the hopper, the material-receiving means with the material-agitating means are simultaneously vibrated, and since the material-agitating means is positioned adjacent to the outlet of the hopper, by the vibration of the material-agitating means, the material is induced to flow from the hopper into the material-receiving means.

(d) Although, like the Wahl heavy duty feeder, the device of the Carrier patent was initially directed to a feeding apparatus insofar as this device includes a vibrated material-receiving means carrying a vibrated material-agitating means position below a supply hopper, the structure and the function of this portion of the device is substantially identical to the structure and function of the device shown in Figure 4 of the Wahl patent in suit.

(e) The Court finds that the device of the Carrier patent has all of the elements of claim 1, with these elements functioning substantially in the same way to produce substantially the same result in the same way

as the device of the patent in suit (R.826-827).

(f) The Court is of the opinion that if the Patent Office had before it the prior art Carrier patent, it would not have granted the claims in the Wahl patent (R.877).

12. The facts concerning defendant's Vibra-Portioner device:

(a) Defendant's Exhibit R is literature distributed by defendant in January of 1962, (R.536-7) prior to any date of invention asserted by Wahl for the device of the patent in suit. Exhibit MM is a portion of the literature issued by defendant showing the structure of the Vibra-Portioner. This device is somewhat different from the device in Carrier patent No. 3,187,884, but in general, performs the same function as the device of that patent. The Vibra-Portioner (Exhibit MM) is a device which induces flow of material from a storage bin and includes a hopper, a material-receiving member vibrationally supported by leaf springs with the material-receiving member carrying a material-agitating member in the form of an upstanding rod and baffle. When vibrated, the material-receiving member and the material-agitating member vibrate simultaneously to induce flow of material from the hopper into the material-receiving means.

(b) The Court finds that the elements of the claims of the Wahl patent are included in the Vibra-Portioner device offered for sale by Defendant in January of 1962, with these elements functioning in substantially the same way to produce substantially the same result as the device shown and described in the Wahl patent (R.861-883).

13. The facts concerning Musschoot patent No. 3,083,811:

(a) The application for the Musschoot patent was filed July 2, 1959, and is prior art to the patent in suit. Defendant's Exhibit LL-2 is the Musschoot patent and LL-1 is a colored chart containing some of the figures of this patent together with material from the specification of the Musschoot patent.

(b) In the Musschoot patent there is disclosed a silo or hopper with sloping sides terminating in a discharge portion. Positioned below the hopper is a material-receiving member, and extending upwardly from the material-receiving member is a material-agitating member which is vibrated simultaneously with the material-receiving member for the purpose of inducing flow of material from the hopper into the material-receiving member. The Musschoot patent states in the specification that the problem to be solved by the device of the patent was inducing the flow of materials which are difficult to handle from a discharge outlet

of the hopper. Reference is made in this patent to the problem presented by arching of hard-to-handle materials.

(c) The Court finds that because the vibratory bin feeder of Musschoot patent No. 3,083,811 includes a material-agitating means carried by a vibrating material receiving member positioned below a supply hopper with the material agitating means extending into the hopper to induce flow of material therefrom, there is included the basic elements of the claims of the Wahl patent, and these elements in the Musschoot device function in the same way as the bin activator in the Wahl patent to produce substantially the same results.

(d) The Court finds that the art cited by the Patent Office was not as pertinent to the claims of the Wahl patent as the device described in the Musschoot patent, and that if the Patent Office had considered the Musschoot patent during the prosecution of the application for the Wahl patent, it is the opinion of the Court that claims of the scope of the claims in the Wahl patent would not have been granted by the Patent Office (R. 859-861).

14. Plaintiff Wahl testified that his invention differed from the prior art and referred to a chart (Exhibit 42) which he stated showed a compaction zone adjacent the discharge outlet of the hopper, and within the material-receiving means, and

that none of the prior art devices included such a compaction zone. He stated that the bin activator of his patent in suit differed from the prior art devices in that it was intended for use with large hoppers and not for use with small hoppers. The Court finds that this attempted differentiation from the prior art was not based upon the structure called for by the claims of the Wahl patent, but upon a general re-definition of what Wahl considered his invention to be. For purposes of avoiding the prior art, Wahl very narrowly construed what he considered to be his invention by placing the material-agitating means and the material-receiving means in a specific location, referred to by him as the compaction zone, but, for purposes of infringement and attempting to read the claims upon certain of defendant's devices, he ignored these specific limitations and gave to the claims a much broader interpretation.

15. The differences between the subject matter sought to be patented in the Wahl patent and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

(a) The scope and content of the prior art.

The prior art relied upon by defendant discloses that as of the earliest date of the filing of the application for the Wahl patent, it was old to have a material-receiving means carried by and positioned below a hopper with a material-agitating

means carried by and vibrated simultaneously with the material-receiving means. It was old to place the material-agitating means within the material-receiving means and adjacent the discharge outlet of a supply hopper. The prior art devices all functioned to induce flow of material from the hopper by the material agitating means into the material-receiving means from which it was discharged. In apparatus and in function, this is essentially the same as the device of the patent in suit.

(b) The level of the ordinary skill in the pertinent art.

The Court finds from the record in this case, and the prior art devices referred to above, that at the time the Wahl asserted invention was made the art of vibration to induce material to flow from a hopper was well known. The level of the skill at that time was such that it was known, or obvious, to a person of ordinary skill in the art to induce flow from a hopper by the use of vibrating material receiving means which carries a vibrating agitating means position within a hopper adjacent to the outlet end of a hopper or just below the discharge end of a hopper, whereby the simultaneous vibration of the material-agitating means and material-receiving means would induce flow of hard-to-handle material from the hopper, thus preventing the bridging or arching of material within the hopper. The witness Dumbaugh, an employee and officer of defendant corporation, testified that he was first employed by defendant on August 1, 1962 when the corporation

had few employees, and that his prior experience did not include any information relative to bin activators, feeders or other vibrating devices. Upon becoming employed by defendant, his initial project was to improve the Vibra-Portioner, then being sold by defendant, and without any experience in the vibrator field, and within a matter of six weeks (Exhibit T), he had developed a device substantially identical with that shown in the Wahl patent functioning in the same way to produce the same result. The Court finds from this evidence it is established that to a person of less than ordinary skill in the art, the device shown and described in the Wahl patent, functioning in the same way to produce the same result, could be developed within a relatively short period of time from the time the problem was first encountered.

16. There is an assertion that defendant's accused vibrating hoppers were copied from plaintiffs' commercial device, and the Court finds, as a fact, that Dumbaugh, an employee of defendant corporation, completed the design of the prototype, which ultimately became defendant's feeders, as early as September 16, 1962, when he modified the Vibra-Portioner then being sold by defendant (Exhibit T) (R. 548-550). Prior to this time he had not seen any of the literature issued by plaintiff (R. 531-33). Some reference has been made to the proposed sale by plaintiff of a feeder to the Austin Company, but the Court finds, as a fact, that the first contact defendant had with the Austin Company job was November 9, 1962, after defendant had completed its modified version of

its Vibra-Portioner (R.653-688). The hoppers made by defendant herein charged to infringe were developed independently by defendant.

17. Carrier Reissue Patent No. 26,291 plays a very important role in the consideration of this case. This is a reissue of patent No. 3,187,884 heretofore referred to as one of the prior art patents.

(a) At the time defendant's counsel was retained by defendant in this case, the existence of the Carrier patent owned by defendant was called to his attention. An examination of this patent and the file history thereof disclosed that although the specification and the drawings showed a material-receiving member carrying a material-agitating member positioned below a hopper, and induced the discharge of material from the hopper to the material-receiving means by the simultaneous vibration of the material-receiving means and the material-agitating means, no claims to this concept were included in the original application. The reissue statute, Title 35 U.S.C., Sec. 251, provides for the reissue of patents under certain circumstances, and because the time limit for the filing of a reissue application had not expired, it was determined that an application for reissue of this Carrier patent should be filed, and this was done.

(b) The application for Carrier patent No. 3,187,884 and the application for the patent in suit were both pending in the Patent Office at the same time. The Patent Office rules provide that, where there are two pending applications disclosing or claiming the same or similar subject matter, an interference will be declared to determine who is the first inventor of the subject matter. The file history of both the Carrier patent No. 3,187,884 and Wahl patent No. 3,173,583 disclose that no interference was declared.

(c) Based upon the record in this case, it is the Court's opinion that, if the Patent Office had declared an interference between the application for the Carrier patent and the application for the patent in suit, Carrier should have been determined to be the prior inventor, and the claims directed to the common subject matter,—i.e., the concept of providing a material-receiving means vibrationally supporting a material-agitating means positioned below a supply hopper would have been awarded to Carrier, and no claims would have been awarded to Wahl.

(d) The fact that the Patent Office granted the Carrier reissue patent with claims dominating the structure shown in the Wahl patent in suit is evidence that the Patent Office, with its expertise, considers that the subject matter disclosed in the original Carrier patent is substantially identical with the disclosures in the Wahl patent in suit.

18. Notwithstanding the foregoing findings of fact holding invalid the claims of the Wahl patent in suit, and notwithstanding the generally accepted rule that an invalid patent may not be infringed, for purposes of completeness, findings will be made concerning the infringement of the claims of the Wahl patent by the various devices made and sold by defendant.

(a) Testimony was offered concerning infringement and the infringement of the claims in the patent in suit by the witness Wahl who, as conceded by plaintiff's counsel, was not an expert in reading patent claims (R.1191). On this matter of infringement and claim interpretation, defendant offered testimony through the witness Fischer, whose background included being a Professor of Engineering, a Dean of Engineering at a University, a law school graduate, and some years in practice as a patent lawyer with admission to practice before the United States Patent Office (R. 750-755).

(b) For purposes of construing the claims of the Wahl patent, and because of the assertion of a file wrapper estoppel, the Court has given consideration to the prosecution history of the application for the patent in suit. Exhibit AA-1 illustrates that claim 1 of the patent in suit, as originally filed in the application, broadly discloses the material-agitating means as being spaced from the inner wall of the conical member, and

rigidly secured thereto without any specific location of the material-agitating means with respect to the conical member. By a Patent Office rejection of January 28, 1964, the Examiner rejected this claim for the reason that the location of the agitating means was recited so broadly that it read upon one of the elements of the prior art Rouse patent. After this rejection, this claim was amended to locate the agitating means as "being disposed within said conical member and extending substantially to the said inlet opening thereof." The Court finds that in order to avoid prior art, the agitating means was specifically located as being within the conical member and extending substantially to the said inlet opening thereof.

(c) The vibrating hoppers sold by both plaintiff and defendant have the material-agitating means located at varying positions with respect to the inlet opening. Sometimes the apex of the cone or baffle, which constitutes the material-agitating means, is positioned substantially below the inlet opening, and in other devices, this material-agitating means is positioned substantially below the inlet opening of the cone member or material-receiving means. In the light of the prosecution history, and the file wrapper estoppel just referred to, the Court finds there is infringement of these claims only if the apex of the cone or the material-agitating means comes within one inch of the inlet opening (R.889-892). There are

some such devices made and sold by defendant, and if the claims are valid, such devices infringe the claims of the patent in suit.

CONCLUSIONS OF LAW

1. In this case the patent in suit is not entitled to the usual presumption of validity because the prior art relied upon in this case was not cited or considered by the Patent Office.

2. The claims of the patent in suit are invalid because anticipated by the heavy duty feeder sold by Vibra Screw more than one year prior to the filing of the original application for the patent in suit.

3. The claims of the Wahl patent are anticipated by the disclosure of Carrier patent No. 3,187,884 and by the Vibra-Portioner sold by defendant prior to any date of invention asserted by Wahl in this case.

4. The claims of the patent in suit are anticipated by Musschoot patent No. 3, 083,811.

5. Alternately, and in addition to the anticipation referred to above, on the question of obviousness, under Title 33 USC, Sec. 103, the Conclusion of Law is reached that the differences between the subject matter sought to be patented in the Wahl patent and the prior art referred to above are such that subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

to which the subject matter pertains.

6. Although plaintiffs have established some commercial success of the devices covered by the patent in suit, such commercial success cannot in a case such as this, render valid a patent otherwise invalid. In any event, commercial success may be used only where there is some doubt as to the validity of a patent. Good and valid patents do not need commercial success to sustain them. Invalid patents cannot be helped by commercial success.

7. Although an invalid patent may not be infringed, the Court finds that if the claims of the patent in suit are valid they are infringed only by each of the devices made and sold by defendant wherein the apex of the cone or material-agitating means comes within one inch of the inlet opening of the vibrating material-receiving means, and this finding is based upon the file wrapper estoppel heretofore referred to.

8. A patent application has a duty to the Patent Office to make a full and fair disclosure of all of the facts which may affect the patentability of his invention. Wahl was under a duty during the prosecution of his application for the patent in suit to disclose to the Patent Office the existence of the heavy duty feeder because this prior art device was much closer to his asserted invention than anything cited by the Patent Office. The failure to call attention to the heavy duty feeder constitutes a fraud on the Patent Office, and the maintenance of this suit based upon the acceptance

of a patent resulting from fraud upon the Patent Office makes this an exceptional case.

9. By virtue of the foregoing conclusion of fraud upon the Patent Office, defendant is entitled to an award of attorney's fees in this case.

WILLIAM E. STECKLER
United States District Judge

Dated: November 5, 1969

FILED
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MICHAEL RODAK, JR., CLERK

No. 73-207

In the
Supreme Court of the United States
OCTOBER TERM. 1973

EUGENE A. WAHL and VIBRA SCREW, INC.,
Petitioners,

vs.

VIBRANETICS, INC.,
Respondent.

RESPONSE TO THE PETITION FOR A WRIT OF CERTIORARI

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VIBRANETICS, INC.,
Respondent.

RESPONSE TO THE PETITION FOR A WRIT OF CERTIORARI

In the Indiana litigation, (CA 65-C-57 U.S.D.C., SD Ind) petitioners sued Carrier Manufacturing Co., Inc. for infringement of patent No. 3,173,583. After the usual discovery proceedings the case was tried before Judge Steckler on November 6, 7, 8, 9, 10, 11, 13 and 14, 1967 to the conclusion of defendant's case. The case was then continued for approximately nine months to August 19, 1968, when plaintiffs introduced testimony purportedly for the purpose of rebutting the case made by defendant. After the filing of briefs and arguments, the trial court entered findings of fact and conclusions of law finding patent No. 3,173,583 invalid because anticipated by certain prior art structures and patents (Appendix 56a - 77a). The trial court also followed the mandate of this court

in *Graham* v. *John Deere Co.*, (381 U.S. 1), on the question of obviousness, and determined the scope and content of the prior art (Appendix 68a), the level of the ordinary skill in the art (Appendix 69a) and concluded that on the question of obviousness the differences between the subject matter sought to be patented in the Wahl patent and the prior art referred to were such that the subject matter, as a whole, would have been obvious at the time the invention was made, to a person having ordinary skill in the art (Appendix 75a).

Thereafter, an appeal was taken to the Court of Appeals for the Seventh Circuit, briefs were filed and a decision was handed down affirming the Judgment of the trial court. In that appeal, it was urged that the trial court had completely missed the technical subject matter of the patent in suit and the prior art, and the court was asked to reverse the Judgment of the trial court.

The decision of the Court of Appeals for the Seventh Circuit appears at Appendix 20a - 55a. Relative to the argument that the trial court completely missed the technical subject matter and that the trial court did not understand the concept of the claimed invention of the patent in suit, the court stated:

> "The record refutes the suggestion that Judge Steckler was led astray. It reveals that he was keenly aware of the issues for decision and the contentions of the respective parties, and actively participated in the examination of the expert witnesses." (Appendix 29a).

In the decision of the Court of Appeals reference is made to the *Graham* v. *Deere* decision of this court (Appendix 42a).

Up to this point in the Indiana litigation, plaintiffs were represented principally by a New York patent law

firm, Pennie, Edmonds, Morton, Taylor and Adams, with Stanton T. Lawrence, Charles E. McKenney and Charles J. Brown of that firm being in attendance at the trial.

A petition for rehearing was filed in the United States Court of Appeals which was denied. The petition for rehearing was filed by new attorneys, Edward A. Haight and Haight, Hofeldt and Davis of Chicago. The thrust of this petition for rehearing was that the trial court and the Court of Appeals were in error with respect to the basic issues presented and that the patent should have been held valid. There is no reference in this petition for rehearing to the proposition that plaintiffs were denied a fair trial or that plaintiffs were precluded from introducing at the trial court level any evidence which was available to plaintiffs.

Similarly, before the trial court in the Indiana litigation, there was no petition for rehearing, nor was their any suggestion that the plaintiffs were precluded from introducing any available evidence, nor was there any motion for a new trial for the purpose of supplementing the record with any new evidence. Indeed, it would be most difficult for plaintiffs to make such an assertion because plaintiffs had a period of approximately nine months from the close of defendant's case before it introduced rebuttal testimony.

Thereafter, a petition for a writ of certiorari in the Indiana litigation was presented to this court and denied. This petition was filed on behalf of the patent owners by Edward A. Haight and John W. Hofeldt patent lawyers of Chicago. There was no suggestion in the petition for a writ of certiorari that the patent owners were denied an opportunity to present all available evidence, the main thrust of the petition being that the trial court

and Court of Appeals for the Seventh Circuit were error with respect to the issue of validity and in holdi the patent in suit to be invalid because anticipated a invalid because the subject matter thereof was obvious the time the invention was made.

In the Kentucky litigation from which this petiti emanates the complaint for infringement of patent N 3,173,583 was filed on January 9, 1971 after the decisi of the District Court in the Indiana litigation, but pri to the decision of the Court of Appeals for the Seven Circuit. Plaintiffs in the Kentucky litigation were pri cipally represented by the New York patent law firm Pennie, Edmonds, Morton, Taylor and Adams wi Stanton T. Lawrence and Charles E. McKenney bei principal counsel. Shortly prior to the decision of t Court of Appeals for the Seventh Circuit in the Kentuc litigation, Percy Foreman of Houston, Texas entered a appearance on behalf of plaintiffs. After the decision the Court of Appeals for the Seventh Circuit, the th local counsel for plaintiffs as well as the New Yo lawyers were replaced. Dugald S. McDougall, a pate lawyer from Chicago then appeared as counsel for plai tiffs together with Percy Foreman and a new local couns from Louisville, J. Leonard Walker.

Defendant's answer was amended to include appropria allegations pleading estoppel under the decision of th court in *Blonder-Tongue* (402 U.S. 313) and a motio for Summary Judgment was presented on behalf of d fendant. This motion was submitted to the trial court o briefs and the trial court applied the *Blonder-Tongu* estoppel mandated by the decision of this court an dismissed the Complaint with an opinion (Appendix 14a 19a).

The District Court in the Kentucky litigation found that there was no valid reason for not applying the *Blonder-Tongue* mandate of this court and found that the trial court in the Indiana litigation properly applied the *Graham* v. *Deere* standards, that in the Indiana litigation the trial court made the findings of fact and conclusions of law in an intelligent understanding of the technical issues involved, and that plaintiffs had been given an ample opportunity to present all evidence available to it. (Appendix 16a - 17a). The District Court in the Kentucky litigation stated:

> "The Supreme Court requires that cases of this type ultimately be decided by the trial court's sense of justice and equity. The facts reveal that plaintiff has been given a full and fair opportunity to litigate and prove the validity of his patent. As already noted, the previous trial lasted eight days and, at the conclusion of proof, patentee was given an additional nine months to offer additional rebuttal evidence. Upon losing at the trial level, plaintiff appealed; he then had ample opportunity to present to the Seventh Circuit his arguments challenging the adverse decision rendered by the District Court. Plaintiff was unsuccessful and took his case to the Supreme Court where his writ was denied. It is obvious that to allow plaintiff to relitigate here, the same issues previously decided, would not serve justice and equity but would in fact have the contrary result." (Appendix 17a)

An appeal was taken to the United States Court of Appeals for the Sixth Circuit from the order dismissing the Complaint, briefs were filed and argument had, and the Court of Appeals entered its decision affirming the Judgment of the District Court (Appendix 1a - 13a). Argument was presented both orally and by briefs to the Court of Appeals for the Sixth Circuit that the District Court improperly applied the *Blonder-Tongue* mandate of

this court. In the decision of the Court of Appeals
the Sixth Circuit the *Blonder-Tongue* decision
thoroughly analyzed and it was pointed out that
District Judge below examined all of the material av
able including the full transcript of the hearing in
Indiana litigation, and that plaintiffs had a full and
chance to litigate the validity of their patent. The Co
of Appeals pointed out that in the Indiana litigat
plaintiffs made the choice of forum and had every
portunity to litigate to the finish. Before the Court
Appeals for the Sixth Circuit, plaintiffs were represen
by J. Leonard Walker of Louisville, Kentucky, Dugald
McDougall of Chicago, Illinois and Percy Foreman
Houston, Texas.

It is interesting to note that the petition for a w
of certiorari in this case presents for the first time lawy
not heretofore heard from in this litigation, namely, T
ford Taylor and David W. Conrad. It appears that the
lawyers have been called upon to pick whatever remaini
flesh there may be from an otherwise dead carcass.

This petition for a writ of certiorari should be deni
because there is not even any assertion in the petition
any of the reasons for granting a writ as set forth
Rule 19 of this court. There is not even asserted th
there is a conflict in the decision below with any decisi
of another court of appeals in the same matter. The i
portant question of Federal Law is whether or not
patent owner is entitled to another trial concerning t
validity of his patent after it has been once held invali
This has already been settled by this court in the *Blonde*
Tongue case. There is therefore no new important Feder
question of patent law presented in the petition.

It is suggested in the petition that in the Kentucky litigation the courts disregarded the limitations set forth by this court in the *Blonder-Tongue* case. On the contrary, a reading of the decision of the Sixth Circuit Court of Appeals (Appendix 1a) and the decision of the Kentucky trial court indicates that very serious consideration was given to the *Blonder-Tongue* decision and scrupulously, the courts applied the mandate of that decision.

The petition suggests that a reason for the granting of the petition is that there has been unanimity of the trial courts and Courts of Appeal in applying the *Blonder-Tongue* decision. Since the courts have been unanimous in their interpretation of the decision of this court in the *Blonder-Tongue* case, there is certainly no reason why this court should again give that subject matter further consideration.

Petitioners also suggest that the District Court was in error in postponing the answers to the interrogatories submitted by defendant until it decided the motion for summary judgment. With a motion for summary judgment pending, it is reasonable to have the court postpone answers to interrogatories. Further, it is suggested that the answers to the interrogatories would indicate that the decision of the trial court in the Indiana litigation would be shown to be erroneous. This is a most unusual assertion because it is based upon interrogatories to which no answers were filed. It is completely speculative for petitioners to assert that these answers would in some way be helpful to petitioners' cause.

In the Indiana litigation, plaintiffs had a full and fair opportunity to litigate the patent in suit, and after a long trial the patent was held invalid. Petitioners now suggest that the Indiana trial court was in error both

with respect to its findings of fact and conclusions of law. Petitioners in effect, assert that the Seventh Circuit Court of Appeals was in error both with respect to the reliance upon the findings of fact and the conclusions of law entered by the trial court, and that the court of appeals for the Seventh Circuit was in error substantively in denying the petition for rehearing. Petitioners in effect, assert that this court was in error in denying the petition for a writ of certiorari in the Indiana litigation. Petitioners assert that the District Court in the Kentucky litigation after reviewing the transcript of the trial in the Indiana litigation was in error in not concluding that plaintiffs were deprived of a full and fair trial in the Indiana litigation and petitioners assert that the Sixth Circuit Court of Appeals, after reviewing the decision of the trial court in the Kentucky litigation was in error in affirming the District Court.

What petitioners are asserting here is that this court should disregard all of the opinions and judgments referred to above and permit plaintiffs to start all over in a new campaign of patent litigation with respect to a patent which has had the consideration of numerous courts. Under the mandate of this court in *Blonder-Tongue* this should be denied. As the court of appeals for the Sixth Circuit stated:

> "Plaintiffs' counsel suggest in their briefs that they should have been accorded a *trial* for the purpose of determining whether or not the prior trial in the District Court in Indiana, which resulted in the adjudication of invalidity, awarded to the plaintiffs a full and fair opportunity under appropriate procedure to present all evidence and witnesses in support of the patent in suit. If we were to accept this theory the whole purpose of the rule laid down by the Supreme Court in *Blonder-Tongue* would be defeated.

We, therefore, hold that such a trial is neither necessary nor advisable in a case such as this where the court in which the subsequent action is pending has available the record from the prior litigation from which it can determine whether the claim of estoppel rests upon a firm foundation based on the requirements laid down in *Blonder-Tongue.*" (Appendix 13a)

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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In The

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October Term, 1972

No. 73-207

EUGENE A. WAHL and VIBRA SCREW, INC.,

Petitioners,

vs.

VIBRANETICS, INC.,

Respondent.

SUPPLEMENTAL BRIEF FOR PETITIONERS

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TABLE OF CONTENTS

Page

Supplemental Brief for Petitioners 1

Table of Citations

CASES CITED:

Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 U.S. 313, 332-34, 350 . . . . . 1, 2

Blumcraft of Pittsburgh v. Kawneer Company, F.2d (C.A. 5th, Case No. 72-3428, July 20, 1973) 2

In The

Supreme Court of the United States

October Term, 1972

No: A-1153

EUGENE A. WAHL and
VIBRA SCREW, INC.

Petitioners,

vs.

VIBRANETICS, INC.,

Respondent.

SUPPLEMENTAL BRIEF FOR PETITIONERS

Respondent's brief in opposition to the petition makes no effort to meet petitioners' demonstration that the decision below is in conflict with the cautionary mandates of *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313, 332-34, 350, and that it raises important questions of federal patent law which should be settled by this Court.

By making initial decisions of patent invalidity potentially terminal, the *Blonder-Tongue* case had magnified the need for full and considered appellate scrutiny of district court judgments of invalidity, in contrast to the unwarranted total reliance on the district

court's findings of fact in which the Seventh Circuit in this case indulged (Pet. pp.15-19). In granting summary judgment without requiring answers to petitioners' interrogatories, or according petitioner any other evidentiary avenue to demonstrate the inapplicability of collateral estoppel, the Kentucky district court nullified the directives of the *Blonder-Tongue* case.

After our petition was filed, we learned that the Court of Appeals for the Fifth Circuit had affirmed the decision of the Georgia District Court in the *Blumcraft* case (Pet. p.13 note 5). *Blumcraft of Pittsburgh v. Kawneer Company*, F.2d (C.A. 5th, Case No. 72-3428, July 20, 1973). The decision takes a broad interpretation of *Blonder-Tongue* and explicitly approves the application against a patentee of collateral estoppel after a single holding of invalidity, even though the invalidity ruling has been preceded by multiple decisions holding the patent valid. To be sure, that is not the question presented by this petition, but the sweep of the ruling underlines our basic contention (Pet. p.12) that some lower federal courts are giving short shrift to the requirements so carefully prescribed in the *Blonder-Tongue* case, and that certiorari should be granted here, where even the opportunity to present evidence against estoppel has been denied, in order to forestall a general trend in this dangerous and, at bottom, unconstitutional direction.

Respectfully submitted,

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